



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Engelhardt et al.
Application No. 08/182,621
Filed: January 13, 1994
Atty Docket No. ENZ-52

: OFFICE OF PETITIONS
: Ms. Nancy Johnson
: Senior Petitions Attorney

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**RENEWED REQUEST TO VACATE ORDER TO SHOW CAUSE WHY
DECISION REVIVING THIS APPLICATION SHOULD NOT BE VACATED**

Dear Commissioner:

This is a Renewed Request to Vacate the Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated ("Order") issued in the above-captioned application.

Petitioner respectfully urges that no fees are due because the Show Cause Order was improperly issued. Nevertheless, should the PTO determine that any fees are required to have the Order vacated, including any extension of time fees, the PTO is authorized to charge Deposit Account No. 50-2929, making reference to Docket Number J10006.

This application first became abandoned March 18, 1994, for failure to reply to the Office action mailed February 17, 1994, which set a shortened period for reply of one month. It is not clear from the record of this file if and when a Notice of Abandonment was mailed. A petition to revive under 37 CFR 1.137(b) was filed December 22, 1994, and was granted by the decision of March 6, 1995. The instant application again became abandoned on December 1, 1995, for failure to reply to the Office action mailed October

31, 1995, which set a shortened statutory period for reply of one month. A Notice of Abandonment was mailed June 12, 1996. A petition to revive under 37 CFR 1.137(b) was filed October 1, 1996, and was granted by the decision of November 26, 1996. The application became abandoned again on July 10, 1997, for failure to reply to the Office action mailed April 9, 1997, which set a shortened statutory period for reply of three months. A Notice of Abandonment was mailed November 12, 1997. A petition to revive under 37 CFR 1.137(b) was filed February 3, 1998, and was granted by the decision of April 15, 1998.

On July 1, 2008, some 13 years after the first petition was granted, some 12 years after the second petition was granted, and some 10 years after the third petition was granted, the USPTO in an apparently “exceptional” action issued an Order to Show Cause (“OSC”) in this and other Enzo applications that had become abandoned. The OSC required a showing as to why the favorable decisions on petition going as far back as some 15 years should not now be vacated. The OSC supposedly justified itself by referring to a purported “pattern” of abandonment and revival of the Enzo applications listed therein, and also cited an innocuous statement made by Enzo’s attorney involving his preparation of a reply in another application unrelated to this application, and at a time unrelated to this application.¹

¹ There, the USPTO refused to accept the statement of unintentional delay as made, subsequently denied that it had refused the petition, and then refused to further consider a renewed, supplemented petition. This egregious course of USPTO conduct towards Enzo in that case was rightfully overturned by the court and remanded to the USPTO for consideration of the supplemented petition. See *Enzo Therapeutics, Inc. v. Yeda*, 477 F.Supp.2d 699 (E.D.Va., 2007). It is significant that the USPTO granted that renewed petition under 37 CFR 1.137(b) (after, however, the OSC was herein issued), which belies the totally fabricated argument advanced herein in support of the OSC that

On November 11, 2008, Enzo filed a Petition to Vacate the OSC, a Petition to Expunge Confidential Information, as the OSC violated the USPTO's own obligation to maintain the confidentiality of several Enzo applications disclosed in the OSC by way of their inclusion when the OSC was made of record in the other publicly available applications, and a petition to expedite consideration of the other petitions. On April 3, 2009, the USPTO granted expedited treatment of the Petition to Expunge, denied expedited consideration of the Petition to Vacate Confidential Information, granted the Petition to Vacate Confidential Information, and dismissed the Petition to Vacate the OSC, setting an extendable two month period for reply.

However, on June 4, 2009, the USPTO issued another OSC. While substantially identical to the first, this OSC only permitted a non-extendible two month period for reply, thus shortening the period for requesting Reconsideration set in its earlier decision of April 3, 2009.

Petitioner Enzo requests reconsideration and vacatur of the Order to Show Cause improperly issued July 2, 2008, and June 4, 2009, and reconsideration of the decision of April 3, 2009, (collectively the "OSC"). In this renewed request, Enzo responds to the allegations made in the Decision mailed April 3, 2009, ("Decision") which dismissed Enzo's previous request filed November 11, 2008, to vacate the Order. In addition, this renewed request includes an exhaustive Declaration by Mr. Ron Fedus, patent attorney

Mr. Fedus' testimony in that other case raises a question in this case—or indeed any other Enzo case-- as to whether the abandonment and delay was unintentional. Enzo strenuously protests its subjection to, and demands its release from, this continued USPTO arbitrary and capricious behavior. Enzo presumes that this renewed petition and supplemental statement made by, *inter alia*, Mr. Fedus, will likewise result in favorable reconsideration herein.

and corporate counsel for Enzo, which details, *inter alia*; the manual docketing system employed by Enzo, and provides specific answers to the questions posed by the Order and Decision for this application. Although Enzo properly believes the Order as issued was untimely, and lacked any reasonable basis for suggesting reconsideration of its previous favorable decisions on revival, Enzo is, to the extent possible after the long passage of time, making a diligent and good faith effort to comply with the Order's request for information bearing on the delay in this application.

The Order Was Improperly Issued

1. The USPTO Lacks Jurisdiction over this Application

Interestingly, the USPTO now contends in the Decision (at 9) that Enzo does not question the USPTO's jurisdiction to issue the Order in this abandoned application; rather it is alleged, Enzo has only contended the Order is "unreasonable.." This is an incorrect interpretation of Enzo's arguments presented in subsection B of the previously filed Request to Vacate the Order to Show Cause. The point of these arguments is precisely that: the USPTO when it had jurisdiction of this case in 1995, 1996 and again in 1998, it then also had the ability to request additional information regarding the delay, and yet it chose not to do so.

The U.S. Court of Claims has explained that, "absent contrary legislative intent or other affirmative evidence, this court will sustain the reconsidered decision of an agency, as long as the administrative action is conducted within a short and reasonable time period." *Belville Mining Company*, 999 F.2d at 1000 (citing *Bookman v. United States*,

453 F.2d at 1265) (emphasis added). The Court of Claims later clarified that "[w]hat is a short and reasonable time period will vary with each case, but absent unusual circumstances, the time period would be measured in weeks, not years." Id. at 1000 (citing *Gratehouse v. United States*, 512 F.2d 1104, 1109 (Ct. Cl. 1975)) (emphasis added). The court added that since this reasonable time period has run, 'there is no longer an opportunity to correct the procedural error retroactively.' Id. at 997 (citing *Gratehouse*, 512 F.2d at 1109). Certainly after the passage of some 13 years from the first decision, 12 years from the second decision, and 10 years from the third decision in this application, the USPTO has lost any opportunity it had to question the delay in this case—particularly since it has not shown that any procedural error was committed by either the USPTO or Enzo in this application.

The doctrine of reliance militates against the propriety of the Order and the belated resurrection of jurisdiction by the USPTO. It must be remembered that this application was revived for continuity with a continuing application filed in 2002. The USPTO apparently overlooks that since the second petition was granted November 26, 1996, Enzo has continuously relied upon (1) that second revival for continuity with eight Continuation Prosecution Applications ("CPA") filed, (2) the filing receipts issued in these continuing applications, in which the USPTO acknowledged the claim for benefit of this application in each continuing application, and (3) the prosecution history of all 8 continuing applications which were accorded benefit of the filing date of the instant application, and since June 9, 2005, the public, due to the pre-grant publication of the instant CPAs on that date, by pre grant publication of the continuation applications, has been able to rely on the published USPTO acknowledgement of that priority claim.

Moreover, Enzo, since the decisions of 1995, 1996 and 1998 in this application, and the public, since the decision in this application became publicly available in as early as June 2005, have both been able to rely upon the assertions of unintentional delay by Mr. Fedus in the petitions, and the USPTO acceptance of the assertions *as made*. That 4 year period of publicly available USPTO acceptance of the Enzo petition herein, and the 10 year period of Enzo's reliance on that acceptance is now improperly and belatedly challenged by the USPTO's assertion in this publicly available file that there is a "question" as to whether those revivals were properly made and accepted in this application. The fact is that the USPTO long ago gave up any jurisdiction that it may have had over this application. Also the doctrine of reliance militates against the propriety of the Order and the belated resurrection of jurisdiction by the USPTO.

Enzo agrees that the courts have held that an administrative agency such as the USPTO, does have the inherent right to reconsider its own administrative decisions, but these same courts also held that this is *not an unlimited right of infinite duration*. Specifically, the USPTO reconsideration must be *timely*. *Dayle v United States*, 169 Ct. Cl. 305, 308 (1965). This is especially so where, as here, valuable rights (such as intervening patent rights arising from the published continuing application, and further its right to the claim of priority from this parent application under 35 U.S.C. § 120) have vested. *Id.* at 308. The USPTO long ago lost its jurisdiction over this application.

In general, an agency right of reconsideration only extends somewhere between several weeks and several years after its initial decision. See *Belville Mining Company v. United States*, 999 F.2d 989, n.12 (6th Cir. 1993)(upholding as timely an 8 month period as intermediate between the matter of weeks upheld by most courts and the years of delay

that are not). More importantly, that right should not be based upon a suspicion of possible intentional delay, but must be based on a solid evidentiary foundation, a circumstance not present here. Due to no fault of its own, Enzo's records of—and memories of-- matters laid to rest so long ago are spotty at best. This is why the courts require reasonable promptness and a sound basis for agency reconsideration of its actions—it is a matter of equity and procedural due process for the involved party. Here, the first petition to revive was filed 280 days after abandonment (unknown number of days after the Notice of Abandonment, since it is unclear from the record of this file if and when a Notice of Abandonment was mailed); the second petition was filed 306 days after abandonment and 111 days after the Notice of Abandonment; the third petition was filed 209 days after abandonment and 83 days after the Notice of Abandonment.

The USPTO has indicated that it generally expects some effort within 3 months after receipt of the Notice of Abandonment, or one year after the date of abandonment as a “criteria” for considering and accepting, without more, the statement of unintentional delay as written. The Response filed with the first petition was an amendment, and the response filed with the second petition was a Request for Continued Examination (“RCE”) and an amendment. The aforementioned continuation applications evidences that the abandonment and delay herein was unintentional. See *Goss International v. MAN Roland, Inc.*, No. 03-CV-513-SM, 2006 U.S. Dist. LEXIS 53245 at *13 (D.N.H. July 31, 2006) (court distinguishing between abandonment of an application that may be properly remedied by way of 37 CFR 1.137(b) where *e.g.*, evidenced by the filing of a continuation application to further prosecution of the disclosed invention, and the irremediable abandonment of the invention itself). Here a total of eight continuation

applications and a CPA have been filed to continue the prosecution of the invention. Indeed, as the Order itself stipulates (at 10), it seeks information regarding Enzo applications, such as the instant application, which are relied upon for priority of invention claims in subsequently filed and prosecuted Enzo applications to those self-same inventions. In other words, the Order targets those very Enzo applications that the Order itself indicates were properly revived. *See Goss, supra*. In March 1995, November 1996 and again in April 1998, a grantable petition required: (i) a statement that “the entire delay from the date that the required reply was due until the filing of a grantable petition was unintentional”; (ii) a proposed response; and (iii) the petition fee (the requirement for filing the petition within one year of abandonment had been removed effective December 1, 1997). 37 C.F.R. § 1.137(b) (1997); see *also* Manual of Patent Examining Procedure (MPEP) § 711.03(c), subsection III, paragraph (F) (8th Ed., Aug. 2001)” the Office will generally require only the statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional...”

The USPTO has published two decisions wherein it reconsidered its previous acceptance of statements of unintentional delay, but there it did so (1) *promptly*, and (2) then only when it had a “smoking gun” document already in hand evidencing that the delay was intentional. See *In re Patent No. 5,665,388* (May 12, 2005)²; *In re Patent No. 5,723,453* (May 12, 2005)³ (Order to Show Cause issued January 27, 2004, seven

² <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5665388.pdf>

³ <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5723453.pdf>

months after decision granting petition under unintentional standard of 37 CFR 1.378(c), based on uncontroverted evidence in documents submitted September 23, 2003). Just as clearly as those reconsiderations were timely, the reconsideration of the decisions in this application is not. See *Belleville, supra*. It should be noted that the documentary evidence of record in the published decisions *irrefutably* showed that the bankruptcy trustee made a business decision not to maintain in force, or reinstate, any of the patentee's patents, advised the lien holder bank not to spend any further funds on the patents, and further, instructed the registered practitioner of record to take no action to maintain or reinstate the involved patents, or to incur any expenses in the matter.

The USPTO has no evidence that a business decision not to continue prosecution was made in this application, or that there was a change in circumstance of the abandonment in this application which led to the revival petition. There is a valid reason why no such "smoking gun" evidence exists for this application: this application was not intentionally abandoned and there was no intentional delay in seeking revival. Moreover, in this application, as well as in every other Enzo application mentioned in the Order, the USPTO has not acted promptly in issuing the Order. In each application the USPTO is simply fishing for evidence to, retroactively, support its belated action. The USPTO makes no effort to explain, much less excuse, its long delay in questioning Enzo, and is conspicuously silent as to what triggered at this late date, the Order in this application. Here, as in every application mentioned in the Order, Enzo had not made any business decisions not to prosecute, or delay in seeking revival of, any of the applications in the Order, nor does the USPTO point to any evidence of such. Most importantly, there is no "smoking gun" evidence of any decision by Enzo not to prosecute, much less

intentionally delay seeking revival, of any already abandoned application in the Order, especially the instant application. Thus, the USPTO's actions in the Order are not consistent with USPTO precedent when it capriciously reconsidered the previously granted petition under the unintentional delay standard in each and every Enzo application mentioned in the Order. Indeed, the only justification beyond the alleged "pattern" of abandonment and revival is the deposition testimony (irrelevant to this application but harmless in any event) of Mr. Fedus made in another Enzo application undergoing an interference, when the lack of co-pendency with a prior Enzo application was discovered during the interference and Enzo sought to remedy its inadvertent error with a petition under 37 CFR 1.137(b). As outlined above, there, the USPTO refused to accept the statement of unintentional delay as made, subsequently denied that it had refused the petition, and then refused to further consider a renewed petition. This course of action was overturned by a Federal District Court which remanded the case to the USPTO for consideration of the supplemented petition. See *Enzo Therapeutics, Inc. v. Yeda* 477 F.Supp.2d 699 (E.D.Va., 2007). Again, it should be noted that the USPTO has since granted that petition and Enzo presumes that this renewed petition and supplemental statement made by, *inter alia*, Mr. Fedus, will likewise result in favorable reconsideration.

2. The USPTO fails to provide a reasonable basis to belatedly question the delay

The USPTO maintains (Decision at 11) that the Order is supported. Specifically, the USPTO contends there is a "pattern of abandonment and revival"

alleged to be apparent from various Enzo applications, so as to justify the Order. Indeed, the USPTO contends without giving any support for its contention, that the abandonment of an application is not a routine matter. In fact, the opposite is true.

Abandonments are Routine at the USPTO

Inspection of the relevant Workload Tables of the USPTO Annual Reports listed on its web site (1993-2008)⁴ reveals that in 1994 and 1995, the years of the 1st and 2nd instances of abandonment of this application number, about *seventy thousand* (70,000) other applications also became abandoned on an annual basis. Clearly, and contrary to the assertion in the Decision, abandonment of an application was (and remains) a rather routine matter at the USPTO.⁵ In the same years, the USPTO processed about 4,000 petitions to revive annually during 1994 and 1995 (the number of those petitions filed under the unintentional standard and their rate of success is not reported). That the vast majority of those abandoned cases were not subjected to attempted revival and permitted to remain abandoned suggests that the abandonment in those cases was not unintentional, or in any event, the delay in seeking revival was not inadvertent, especially given that while the 1 year filing requirement for a petition under 37 CFR 1.137(b) had been removed, the USPTO indicated it might investigate

⁴ See <http://www.uspto.gov/web/offices/com/annual>

⁵ For 2008, the year the Order was issued, the USPTO indicated that about *two hundred nine thousand* (209,000) applications became abandoned and that it processed about 10,000 petitions to revive. From 1993 through 2007, the years spanned by the Order, over *1.3 million* applications were reported abandoned.

petitions filed more than 1 year after abandonment. Moreover, the fact that only a few attempts to revive were filed, as compared to the huge number of applications abandoned but were obviously *not* subjected to revival attempts that year, serves as objective support of Enzo's assertion in the 1994 petition that the delay in prosecution in this application and in filing the petition was unintentional.

In 1997, the year of the third abandonment of this application number, about *sixty four thousand (64,000)* other applications also became abandoned, with the PTO processing about 2,800 petitions that year. Clearly, and contrary to the assertion in the Decision, abandonment of an application was (and remains) an even more routine matter at the USPTO in 2001 than in 1999. In the same year, the USPTO processed about 4200 petitions to revive (the number of those petitions filed under the unintentional standard and their rate of success is not reported). That the vast majority of those abandoned cases were not subjected to attempted revival and permitted to remain abandoned suggests that the abandonment in those cases was not inadvertent, or in any event, the delay in seeking revival was not inadvertent, especially given that while the 1 year filing requirement for a petition under 37 CFR 1.137(b) had been removed, the USPTO indicated it might investigate petitions filed more than 1 year after abandonment. Moreover, the fact that only a few attempts to revive were filed, as compared to the huge number of applications abandoned but were obviously *not* subjected to revival attempts that year, serves as objective support of Enzo's assertions in the 1994, 1996 and 1998 petitions that the delay in prosecution in this application and in filing the petition was unintentional.

Revivals Are Also Routine at the USPTO

Of course, there would be no “pattern” (discernable or not) of abandonment and revival if the USPTO had not granted the petitions herein and revived this application number and the others listed in the Order. But, after all, it is the USPTO, not Enzo, who rightfully granted the petitions to revive this application. Indeed, the Decision admits (at 10) that “[i]t is true that the Office generally grants petitions under 37 CFR 1.137(b).” The MPEP in effect in December 2001, makes clear that a petition to revive under 37 CFR 1.137(b) would generally be granted:

the Office will generally require only the statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. . . .”

see Manual of Patent Examining Procedure (MPEP) § 711.03(c), subsection III, paragraph (F) (8th Ed., Aug. 2001).

Furthermore, there was no letter of express abandonment of record in this file or any other indicia that would, then or now, trigger any further inquiry into the delay in this application. Indeed, the administrative record of this application amply supports the correctness of the revival of this application. Furthermore, the administrative records of the other Enzo application listed in the Order support the revivals in those cases. As argued previously, the fact that other Enzo applications may have later become abandoned (and revived) has no bearing on the question of delay in this application. The USPTO rejects this argument as meritless, and contends that as other Enzo application have become abandoned “on a regular basis” and revived, some of

them with petitions filed close to one year from abandonment, this is somehow “significant”.

For the entire period involved in the Order, the USPTO had a full record of the cases and their status. Taking years-old, even decades-old information regarding other applications and putting it into a table does not somehow magically convert it to new information that is relevant to this application.

The mantra of the alleged “pattern of abandonment and revival” by which the USPTO seeks to impart disproportionate weight to questioning the delay in other cases to the petition herein, is an issue already decided in Enzo’s favor in this case, particularly since this application number became abandoned twice. How the USPTO could have failed to notice that fact at the time the second petition was filed, and then again when the third petition was filed is not explained in the Order, or how Enzo could have somehow withheld that fact from the USPTO, is likewise not explained in the OSC. Indeed, the Federal Circuit has rejected a similar approach, not of direct evidence, but of mere assertion and innuendo, to try, by repetition, to make a case that would unfairly force a detailed rebuttal by Enzo. See *Magnivision, Inc., vs. Bonneau Co.*, 115 F.3d 956, 960, 42 USPQ2d 1925, 1929 (Fed. Cir. 1997) in which the court also noted:

The assertions and innuendos of impropriety were [improperly] magnified by repetition. See *Louisiana Ass'n of Independent Producers and Royalty Owners v. Federal Energy Regulatory Comm'n*, 958 F.2d 1101, 1119 (D.C. Cir. 1992) (a party “cannot, by sheer multiplication of innuendo, overcome the strong presumption of agency regularity”) (quoting *United States v. Morgan*, 313 U.S. 409, 421 (1941)).

The presumption of USPTO regularity in the revivals of this application simply cannot be overcome by the mere allegation of a “pattern” of abandonment and revival in other Enzo applications. This application did become abandoned three times and despite the regulation authorizing further inquiry by the deciding official *at that time*, no additional information was requested. Indeed, Enzo’s surviving records show that for the 3rd instance of abandonment, both the Office Action and the petition were docketed for reply on a monthly basis but as explained by Mr. Fedus, the status of an application was not updated on the docket reports. Just how many other petitions in other, non-Enzo applications were filed in 1998 at around the same time frame as the present application is not provided by the USPTO (i.e. is Enzo somehow unique in this matter) which points to its arbitrary and capricious inclusion of this application in the Order. To help place things in proper perspective, during the years from 1992 to 2007 which span the Order listing of the involved Enzo applications, over *1.3 million application became abandoned at the USPTO* .

The Decision of April 3, 2009 conveniently (for the USPTO), but without evidentiary or legal basis, dismisses this argument as being “without merit.” The contention that there is a “pattern” of abandonment *and* revival in other Enzo applications listed in the OSC is simply due to the fact that the USPTO routinely revives abandoned applications under the unintentional standard of 37 CFR 1.137(b). The dismissal itself admits as much at 10 (“[I]t is true that the Office generally grants petitions under 37 CFR 1.137(b)”). The fact that several Enzo applications out of Enzo’s entire portfolio became abandoned over the 15 year period year mentioned in the Order (Table bridging pp. 11-12) is shown by the attached Declaration of Mr. Ron

Fedus to be attributable to *inter alia*, (1) the use of a manual docketing system that did not automatically calculate reply dates; (2) the non-receipt by Enzo of several of the Office actions and/or Notices of Abandonment as apparently happened in this application, coupled with its aforementioned docketing system; (3) these applications are all in the field of Biotechnology, wherein complex, extended, and vigorous prosecution is a fact of life and Mr. Fedus always sought to present to the USPTO a complete reply to all issues, often having to consult with internal inventors and other industry experts and prepare declarations in addition to formulating responses and amendments to the Office actions⁶; and (4) Mr. Fedus was, for almost the entire 15 year period noted in the Order, Enzo's only patent counsel (and corporate counsel) who had a very full plate: licensing negotiation, litigation; opposition; and the preparation and prosecution of the hi-tech Enzo application families noted previously.

The Decision asserts (at 11) that Enzo has wrongly suggested that the USPTO must provide evidence that the delay was intentional. The decision further makes the incorrect assertion (at 9) that Enzo allegedly does not question the Office's jurisdiction to issue the Order in this abandoned application.

Enzo points out that after 13, 12 and 10 years of USPTO acceptance of Enzo's prior statements of unintentional delay in this application, that equity alone would suggest the USPTO needs something more than a dubious basis to reopen the matter of

⁶ Attention is drawn to the fact that the Manual of Patent Examining Procedure was uniquely amended on and after August 1993 (5th Ed. Rev 15) to include a chapter drawn to the practice and procedures relating to a specific area of scientific endeavor: Biotechnology.

the delay in this application, which was long ago decided in Enzo's favor. This is particularly so since the USPTO has already repudiated its own allegation of Enzo wrongdoing by reviving the very application for which Mr. Fedus' remarks were cited in the OSC as a basis for further questioning Enzo delay in the Order. In other words, this application—and its continuing applications have long and properly enjoyed the presumption of administrative correctness of the revival—and both the USPTO and Enzo have long and properly relied upon the favorable decision on petition. Enzo agrees that the USPTO, like any other administrative agency, does have the inherent right to reconsider an administrative decision, but strenuously insists that this is not an unbridled right of infinite duration as the USPTO apparently believes. The USPTO long ago lost its jurisdiction over questions of delay in this application.

In the '621 application, the second and third petitions to revive were filed, respectively, 111 days and 83 days after the Notice of Abandonment. It is unknown what the number of days is for the first petition to revive since it is not clear from the record of this file if and when a Notice of Abandonment was mailed. The USPTO has indicated that it generally expects some effort within 3 months after receipt of the Notice of Abandonment, or one year after the date of abandonment as a "criteria" for considering and accepting the statement of unintentional delay.

The Order admittedly focuses on those Enzo applications revived for continuity with a continuing application. This suggests that the USPTO seems to disapprove of—or find suspicious--Enzo filing a continuation application to continue prosecution of a given invention, as opposed to a substantive reply in the earlier application. Note that is precisely what happened in this instance; Enzo did file a substantive reply and yet is still

being targeted in this application—perhaps because Enzo has filed 4 continuing applications.

The USPTO fails to appreciate the distinction between the inadvertent abandonment of an application, which is properly revived under e.g., 37 CFR 1.137(b), and the irremediable abandonment of the underlying invention, which is not. Irrefutable evidence that the underlying invention in this application was not intentionally abandoned is the fact that 4 continuing applications were filed to continue the prosecution. See *Goss, supra*. By focusing on those Enzo applications having continuing applications, the USPTO also overlooks that even given its long acceptance of continuing applications as proper reply. This is a matter of policy as noted in the MPEP of 1992, and was expressly added to USPTO regulation (37 CFR 1.137(b) (1)) in 1993 (and remains continuously to this day) which expressly authorizes that a petition may be accompanied by either a substantive reply or *the filing of a continuing application*. Accordingly these actions are equivalent responses by the USPTO's own formally stated policy and the mere fact that either a continuing application was filed, or as here, a substantive response is not, *ipso facto*, evidence of intentional delay in prosecution or revival. See also *Goss, supra*.

Indeed, as Mr. Fedus makes clear in his Declaration he always sought to provide a substantive reply to accompany a petition to revive. It was only when he could not timely prepare that substantive reply to advance prosecution that he would file a continuing application as the proposed response to continue prosecution—which was as noted above was and is entirely proper under the rules of the USPTO. Now, however, the USPTO Decision flies in the face of its own rules and suggests the filing of a

continuation application as the reply to accompany a petition to revive as somehow indicative that there may have been intentional delay on the part of Enzo. This baseless contention does not survive a mere inspection of the USPTO's own rules.

The administrative record shows that the revivals were in accord with USPTO procedure and policy.

The USPTO has reconsidered its previous acceptance of statements of unintentional delay, but did so (1) promptly, and (2) when it had a "smoking gun" document already in hand evidencing that the delay in that case was intentional. See *In re Patent No. 5,665,388* (May 12, 2005) <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5665388.pdf>; *In re Patent No. 5,723,453* (May 12, 2005) <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5723453.pdf> (Order to Show Cause issued January 27, 2004, seven months after decision granting petition under unintentional standard of 37 CFR 1.378(c), based on evidence in documents submitted September 23, 2003).⁷

The Request for Information

Notwithstanding the USPTO's lack of jurisdiction to now reconsider the grants of the petition of over 6 years ago, Enzo is making a good faith effort to reply to the Order.

⁷ It should be noted that the documentary evidence of record irrefutably showed that the bankruptcy trustee made a business decision not to maintain in force, or reinstate, any of the patentee's patents, advised the lien holding bank not to spend any further funds on the patents, and further, instructed the registered practitioner of record to take no action to maintain or reinstate the involved patents, or even to incur any expenses in the matter.

It must be stressed however, that again, the USPTO is overstating its case here as to what actually can be demanded pursuant to 37 CFR 1.137(b), and as such Enzo is concerned that the additional statements and available evidence adduced with this petition will be improperly faulted by the USPTO.

Specifically, the Order requires (at 10), in addition to the “statements” actually permitted under the rule “*copies* of the relevant docket entries, including a *showing* of what action (or inaction) was docketed for a date three months from the mail date..., what action(or inaction) was docketed for a date six months, and what date was docketed for a date 1 year.... It is expected the *record would include...*”

The USPTO is reminded that the requirement for a “showing” is only found in 37 CFR 1.137(a), which is immaterial to the instant petition and Order. The requirement for a showing accompanied by docket evidence is simply not found in or authorized by 37 CFR 1.137(b). The Order and the Dismissal are overlooking the USPTO’s own interpretation of section 1.137(b). See the *Official Gazette* Notice entitled “Clarification of Application Revival Procedures (37 CFR 1.137)” published Aug. 31 1999 (emphasis added):

The PTO anticipated that the December 1997 revision to 37 CFR 1.137 would reduce the number of petitions under 37 CFR 1.137(a) (on the basis of “unavoidable delay”.) This is because petitions under 37 CFR 1.137(b) require less effort (**statement(s) rather than a showing accompanied by documentary evidence**) and are **evaluated under the less stringent “unintentional delay” standard.** ..Even if the PTO requires further information in a petition under 37 CFR 1.137(b), the petition under 37 CFR 1.137(b) is significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The PTO is almost always satisfied that “the entire delay...was unintentional” on the basis of statement(s) by the

applicant or representative explaining the cause of the delay
**(accompanied at most by copies of correspondence relevant to the
period of delay.)**(Emphasis added)

Nevertheless, Enzo affirms that it has made diligent efforts to comply with the Order since it was first issued and has tried to locate the requested documentary evidence such as docket records, correspondence relevant to the period of delay, etc. However, due to the extraordinary period of delay by the USPTO in reconsidering the petition herein, many of the records pertaining to the applications in issue have been lost or disposed of because of the passage of time (up to 16 years), the moving of offices, and the lack of storage space and a central server. In addition, at least three catastrophic computer malfunctions destroyed Enzo's records pertaining to patent prosecution matters.

Enzo herewith submits statements from: Mr. Barry Weiner ("Weiner"), Enzo Biochem ("Enzo") co-founder, President, and Chief Financial Officer, Mr. Ron Fedus ("Fedus"), Enzo Corporate Counsel and a patent attorney (from 1993 until about 2005 Enzo's only patent attorney), Ms. Lisa Curtin ("Curtin"), who was Enzo's docket clerk from June 1997 until April 2003; Ms. Amanda Liu, a paralegal, who handled the Enzo docket records from 2005 onwards; and docket records that could be found relating to the present application. These declarations and attached documents provide in narrative form as much of the information requested by the Order as can be found or recalled.

The Weiner Declaration

Mr. Weiner's Declaration attests that, despite the difficult financial situation at Enzo throughout most of the period covered by the Order which necessitated a drastic

reduction in in-house legal and IP personnel, Enzo never deliberately abandoned an application nor delayed its prosecution. The USPTO should note this attestation confirms the statements made in the two granted petitions of record in this application. Indeed, as Mr. Weiner declares, the revenues derived from its patent portfolio were crucial to Enzo's survival during this time of its "shoestring" operations.⁸

While the USPTO raises the allegation of intentional delay on the part of Enzo in either prosecution or revival, Mr. Weiner clarifies that Mr. Fedus' diligent and successful prosecution of its applications to generate an income stream for Enzo was essential to Enzo's continued livelihood; obtaining more patents was an Enzo priority. It would only hurt Enzo's precarious financial position to deliberately delay prosecution or revival of a given application.

Further relevant to the issue of abandonment of Enzo applications is Mr. Weiner's statement that when Ron Fedus was hired in 1990, he was one of four Enzo in-house IP and corporate attorneys, but by 1993, Mr. Fedus was Enzo's *sole* in-house attorney, and remained so until 2003; now Enzo has two full time IP attorneys. In other words, for most of the period set forth in the Order, Mr. Fedus had a workload that was formerly handled by 4 Enzo attorneys, but due to Enzo financial concerns, his support staff was not increased. As declared by Mr. Weiner (and affirmed in more detail by Mr. Fedus in his declaration discussed *infra*) Mr. Fedus had primary responsibility for Enzo's 50 patent families and trademark matters including U.S. and foreign patent and trademark

⁸ The USPTO appears to overlook that, all things being equal, it would have actually been less expensive for Enzo to have maintained pendency of this application, rather than remit the 2 expensive 1.137(b) petition fees and the continuing application. This further confirms the inadvertence of the abandonments in this application.

prosecution, opposition and interference proceedings, and litigation involving Enzo's intellectual property rights. In addition, Mr. Fedus handled non-intellectual property matters including real estate transactions, licensing matters, contracts, and even at least one employment related lawsuit against Enzo. It therefore should not come as a surprise to the USPTO that prosecution deadlines in some Enzo applications were inadvertently missed, and, moreover, were not discovered or remedied until more time passed. This is even more understandable in light of Enzo's docketing and filing systems, discussed in more detail by Mr. Fedus in his Declaration, and by Ms. Curtin and Ms. Liu in their respective Declarations, and supplied as requested by the Order.

The Fedus Declaration

Mr. Fedus reiterates the statements of unintentional delay made in the petition of record in this application: that in each application listed in the Order, the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional and that the abandonments of the applications in issue were also unintentional.

Mr. Fedus also recounts the diligent efforts he made (including four trips: on July 10, August 27, September 2, and September 10, 2008) to visit off-site storage facilities and former Enzo office to recover any available documentary docketing evidence requested by the order. He explains that due to the long time involved, three computer failures, and several corporate relocations, his efforts to locate his detailed prosecution chronologies and Enzo patent dockets for the applications listed in the Order were mostly unsuccessful.

Of particular relevance to the Order is Mr. Fedus' explanation of the docketing system as it existed for most of the period set forth in the Order. Mr. Fedus notes that as a matter of his general policy, he always tried to reply in the fullest, and never abandoned an application (which he later attempted to revive) intentionally or intentionally delayed filing the petition and response to the outstanding Office action. In situations where an application became inadvertently abandoned, revival deadlines were docketed when Enzo became aware of abandonment, which was mostly at the time of receipt of a Notice of abandonment

Docket entries such as due dates, once calculated, were not removed after a response was filed but were removed or updated, if at all, only after receipt of an Office Action. As a result, the docket did not always reflect the actual status of an application. It was necessary to check the application file when the patent docket did not indicate a response was filed and/or was due. Because the patent docket was manual, there were times when due dates were missed simply because Mr. Fedus had not been apprised that a deadline was imminent. Given the docketing system in place by Enzo for most of the time period covered by the Order, that did not apprise Mr. Fedus of the status of an application (other than one having notation that a petition to revive was needed) this reinforces Mr. Fedus' statement that he did not intentionally permit an application to become abandoned. The USPTO is respectfully reminded that while the submission of evidence of a highly sophisticated, reliable docketing system is essential to showing unavoidable delay in a petition filed under 37 CFR 1.137(a), that is immaterial to each and every application mentioned in the OSC, since Enzo has continuously asserted *ab initio* that the delay in every application was unintentional within the meaning of 37 CFR

1.137(b); Enzo does not have to show that it had in place a reliable and sophisticated docketing system to establish that the delay was unintentional. Indeed, the docketing system actually employed at Enzo for most of the period relative to the OSC reinforces Enzo's contention that both the abandonment and any delay in filing the petition were unintentional.

It was Mr. Fedus' general practice to monitor pending applications, but nonetheless, a small percentage of his active prosecution matters inadvertently became abandoned. This proactive monitoring is amply demonstrated in several instances noted by Mr. Fedus where he actually prepared and filed a petition to revive under 37 CFR 1.137(b) either in advance of Enzo's receipt of the Notice of Abandonment, or notwithstanding that a Notice of Abandonment was ever mailed by the USPTO or received by Enzo, in three of the applications listed in the Order: '067, '576, '075. Clearly, such proactive monitoring is inconsistent with the USPTO's allegation that there was intentional delay in either prosecution during pendency or in filing petitions to revive in the applications listed in the Order, particularly since Enzo's manual docketing system meant that Enzo's first awareness of the fact of abandonment was either receipt of Notice of Abandonment as in this application, or a call from the examiner checking to ascertain whether a response had been filed. As such, it is not understood how these three applications suggest any deliberate actions (or inactions) on the part of Enzo in seeking revival as to support the allegations made in the Order.

Indeed, the USPTO records in Enzo applications are demonstrably less than fully accurate, and to base the OSC on inaccurate USPTO file records and incorrect or incomplete USPTO activities is particularly unseemly. For example in application No.

11/403,117 Enzo has filed a petition to withdraw the erroneous holding of abandonment due to Enzo's demonstrated failure to receive the Office Action of October 29, 2008. This lack of receipt is due in turn to the USPTO failure to follow its own stated procedures for changing a correspondence address. That is, a correspondence address may only be changed by (1) the written concurrence of all named inventors, or (2) the written instructions of the attorney of record, or (3) the written instructions of the assignee of the entire interest upon its becoming of record. In this case however, a paper filed by a person with a similar name with that of one of the named inventors in application 11/403,117 was somehow matched up with that Enzo file, and despite the presence of but one signature in an application naming joint inventors, the correspondence address was improperly changed by the USPTO such that Enzo did not receive the next USPTO communication; rather it was mailed to the address of a third party. Nevertheless, in spite of the obvious error by the PTO in mailing the Office action to an incorrect address based on PTO's incorrect handling of a change of address filed by an unauthorized person, the PTO nevertheless refused to vacate the holding of abandonment and instead, insisted that Applicant, Enzo, file a Petition demonstrating that the Office Action was not received. That Petition is still awaiting a decision by the PTO. The significance of this recent PTO error is to raise the possibility that the PTO may have committed similar errors relative to one or more of the applications that are now belatedly being subjected to the OSC, as it raises a question as to whether an Office action in one or more of the cases being subjected to the OSC was even properly mailed by the PTO. Had the PTO refused to grant the petitions to revive around the time when they were filed, Enzo would have been in a position to review its records more closely to see if PTO

error may have caused some of those abandonments. It is patently unfair for the PTO to ignore errors it makes in its mailing of Office actions as clearly demonstrated in application 11/403,117 and yet be able to revisit many years later earlier grants of petitions rendered, long after Enzo could be reasonably expected to have possession of records that would substantiate the correctness of statements made by a registered practitioner in good standing.

The Order also notes, in support of its alleged pattern of supposedly deliberate Enzo “abandonment and revival,” that several of the applications listed in the Order were revived at or near the 1 year date and as such, implies that there was deliberate delay in revival. As Mr. Fedus notes in his Declaration, however, revivals were docketed on the monthly anniversary including the 1 year “deadline”. Ms. Lisa Curtin explains in her Declaration that she routinely docketed petitions to revive an abandoned application on a monthly basis based on both the actual date of abandonment as well as the date of the Notice of Abandonment. This is an important point for the UPSTO to consider. The USPTO seems to imply that Enzo, in those applications listed on the Order, docketed the petitions to revive *only* at the one year date and promptly forgot about those applications for an entire year. Moreover, it is one thing to simply docket an application for revival on the 1 year anniversary date and then take no further action for an entire year, and another thing, as Enzo did, to docket it for revival *throughout* that year, begin work on that revival petition and its necessary response to continue prosecution as promptly as conditions permit, and annotate the 1 year anniversary date as a “fail safe,” prudent reminder to guard against unintended forfeiture if the petition had not already been filed. This is precisely what happened here.

Mr. Fedus also includes in his Declaration, along with his general background discussion as to docketing at Enzo, and exemplifies his typical procedures using the '073 application as an illustrative example. For those applications abandoned prior to the advent of Ms. Lisa Curtin's handling of docketing work, the usual Enzo practice was for the secretary (or Mr. Fedus himself, during the absence of competent secretarial help) to write or stamp the date of receipt of an Office action and docket the due date for Reply. Due to the passage of time, corporate law office relocations, and personnel turnover, memories have faded, and earlier Enzo records cannot be found. Nevertheless, the docketing system employed by Ms. Curtin beginning in 1997 reasonably followed the prior practices at Enzo.

The Curtin and Liu Declarations

The Declarations of Ms. Lisa Curtin, whose duties included docketing at Enzo from 1997-2003 and Ms. Amanda Liu, Enzo paralegal, who took over the docketing responsibility from 2005 to the present, are included. The surviving docket records attached to Ms. Curtin's Declaration demonstrate Enzo docketing procedures in general, and are relied upon to show Enzo's general approach to docketing replies to Office Action and the petitions to revive, which were followed in this application. Although Ms. Liu's docket work is subsequent to the time period relevant to this application, her statements corroborate Mr. Fedus' Declaration.

It is submitted that this renewed petition, and the attached Declarations and exhibits are an adequate reply to the Order, and refute the allegations of intentional delay

in prosecution and in submitting the petition to revive, and as such again confirm the affirmations made in the original petitions to revive.

The '621 Application

The present application had three instances of unintentional and inadvertent abandonment . In the first instance, a notice to file missing parts was issued on 02/17/1994 setting a one month response period. Mr. Fedus states that no docket log can be located for this time period and, hence, there is no documentary evidence to show how the Office action may have been docketed. This is during the period prior to Ms. Curtain's taking responsibility for keeping a docket log and after the time when Ms. Brenner and various secretaries maintained a docket log. While Mr. Fedus does not recall how docketing was done between 1993 and 1997, he believes that some docket log may have been maintained by a secretary and that he entered due dates into his desk calendar.

Mr. Fedus does not recall when he became aware of the first abandonment in the '621 application and no notice of abandonment was received by Enzo. Mr. Fedus does not recall working on the response or on the petition to revive but he states that, as it was his usual procedure he worked diligently and continually in all of his prosecutions. No docket records have been found relative to this first instance of abandonment.

A petition with needed reply to the Office action was mailed to the PTO on December 22, 1994 which is 280 days from the abandonment date of March 17, 1994. The petition filing was well before the one year date from the date of abandonment and the petition was granted on March 6, 1995.

Mr. Fedus was the only patent attorney at Enzo during this time period and his duties included litigations, oppositions, licensing and other general legal matters for Enzo. While Mr. Fedus does not have a specific recollection of what occurred up to the filing of a petition, Mr. Fedus states that he knows that, in no case, including the '621 application was there any intentional delay in the preparation of a reply and petition to revive.

After the first revival, as far as Mr. Fedus and Enzo knew, the '621 application was pending and awaiting action by the examiner. Mr. Fedus' records indicate that on June 7, 1995, a call was received from the PTO enquiring whether Enzo had responded to the pending Office action. An inspection of the '621 file indicated the no Office action had been received. A notice of abandonment was mailed by the PTO on June 12, 1996 and was received by Enzo on June 17, 1996. No docket records have been found relative to this asserted second instance of abandonment. The petition to revive and reply to the Office action was filed on October 1, 1996 by Mr. Fedus. Mr. Fedus states that he could not have timely filed a response to the Office action since it was not received by Enzo. Mr. Fedus took steps to remedy the situation after becoming aware of the abandonment in June 1996 and he acted diligently to revive the '621 application 111 days from the date of becoming aware of the abandonment. Mr. Fedus reaffirms in his Declaration that the delay in taking action was unintentional.

A third Office action was received by Enzo some time after its April 4, 1997 mailing date and was stamped as received and docketed for a three month response date. Mr. Fedus does not recall the circumstances, but Mr. Fedus' files have a notation dated November 7, 1997 to the effect that he placed a call to the examiner. The examiner was told that a response and petition to revive would probably be filed by the end of 1997. Mr. Fedus believes that the call to the examiner may have been in answer to the examiner's call inquiring as to the status of the application. The notice of abandonment was mailed to Enzo on November 12, 1997. However, it was not received by Enzo. In response to a call by Enzo, the examiner left a voice mail on December 7, 1997 where the examiner indicated that the PTO computer shows that the notice of abandonment was mailed. The examiner ordered the '621 application file and promised to fax the notice of abandonment to Enzo. Shortly thereafter, on February 3, 1998, the petition to revive was mailed. In the petition, Mr. Fedus indicated that the petition was filed "...within the three month period from the mailing of the Notice of Abandonment pursuant to the [] new December 1, 1997 rule." A request for a continuing application and a preliminary amendment were mailed along with the petition and fee. Mr. Fedus believes that his actions in this instance evidence the fact that he never intended to delay the filing of any petition to revive or to utilize the petition filing as an improper extension of time.

A copy of the docket log is attached, wherein the log was modified to include a header for reference purposes, i.e., "J10006 DOCKET LOG EXHIBIT p. 1-5". Additionally, specific entries that are not relevant to the present application have been redacted and annotated with the letter designation nn. The following entries are relevant to the present application, which was assigned by Enzo docket number ENZ-52:

Third Abandonment with Notice of Abandonment on November 12, 1997:

11/11/97 ENZ-52 - Revive (10/9/97 6 mo. deadline to respond to 4/9/97 OA passed) (Docket Log Exhibit p. 1);

12/15/97 ENZ-52 - RCF & JJS should discuss in light of JJS 12/8/97 letter (Docket Log Exhibit p. 2);

1/2/98 ENZ-52 - If notice of abandonment not received, do status check in PTO - last OA was 4/9/97; left voice mail with examiner on 12/30/97 advising notice of abandonment not yet received (Docket Log Exhibit p. 2);

2/3/98 ENZ-52(C) - Petition to Revive Application Serial No. 08/182,621 filed 1/13/94 - filed this date; Granted 4/15/98 (Docket Log Exhibit p. 3);

4/14/98 ENZ-52 - Filed Terminal Disclaimer via fax (when revived, review whether TD had to be filed as app. is pre-Gatt - also, if TD is proper, investigate whether TD's have to be filed for divisionals); Accepted by PTO 4/15/98 - Period disclaimed is 9 mos. (Docket Log Exhibit p. 4);

7/9/98 ENZ-52 - Last day to revive (last OA dated 4/9/97) (Docket Log Exhibit p. 4-5);

7/9/98 ENZ-52 - Revive (4/9/97 OA not responded to) or ASAP

NOTE: Really must be revived within 3 mos. of Notice of Abandonment (Docket Log Exhibit p. 5);

The docket entries reflect the filing of the 3rd Petition to Revive on February 3, 1998 and the grant of the Petition on April 15, 1998. The entry "NOTE: Really must be revived within 3 mos. of Notice of Abandonment!" made on July 9, 1998 clearly reflects a practice of docketing for filing a Petition to Revive within the three month period of prima facie promptness defined by PTO policy at the time.

The petition to revive was filed 83 days from the date of the notice of abandonment and 209 days from the abandonment of the application. This constitutes prompt filing of the Petition within PTO recognized time frames.

While there is no documentation to support Mr. Fedus' efforts in the filing of the petition, Mr. Fedus states that he followed his usual procedure for responding to an Office action and that his efforts to timely file the petition to revive were diligent and continual. This time period is still the period during which Mr. Fedus was Enzo's sole patent attorney and during which there were litigations and other legal responsibilities which Mr. Fedus had to handle for Enzo. *See Fedus Declaration and Weiner Declaration.*

The foregoing confirms that the USPTO revivals of this application were proper.

Relief Requested

It is respectfully requested that the USPTO provide the following relief:

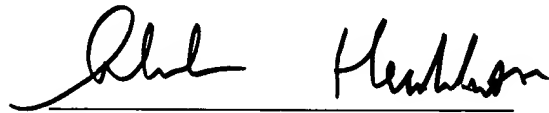
(1) Vacate the Order issued in the above-captioned application as an untimely attempt to reconsider previous decisions of the USPTO; and

(2) as being based on insufficient evidence that the earlier grants of the petition under 37 C.F.R. § 1.137(b) were not proper;

(3) thereby confirming the correctness of the earlier grants of Petitions to Revive filed in the above-captioned application as well as all applications subject to the Order to Show Cause.

Favorable consideration is respectfully requested.

Respectfully submitted, HERSHKOVITZ & ASSOCIATES, LLC



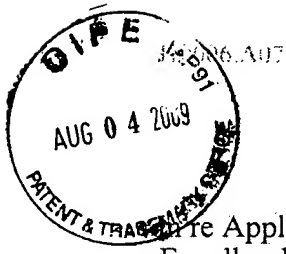
Abraham HersHKovitz
Reg. No. 45,294

Gene Rzucidlo
Reg. No. 31,900

Brian Hearn
Reg. No. 62,370

Dated: July 31, 2009
HERSHKOVITZ & ASSOCIATES, LLC
2845 Duke Street
Alexandria, VA 22314
Telephone: (703) 370-4800
Facsimile: (703) 370-4809
www.hersHKovitz.net

J10011.A06; AH/GR/BH/cgvr



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of
Engelhardt et al.
Application No. 08/182,621
Filed: January 13, 1994
Atty Docket No. ENZ-52

: OFFICE OF PETITIONS
: Ms. Nancy Johnson
: Senior Petitions Attorney

Confirmation Number: 8894

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22314-1450

OFFICE OF PETITIONS

**DECLARATION OF RONALD FEDUS IN SUPPORT OF
PETITION REQUESTING THAT AN ORDER TO SHOW CAUSE BE VACATED**

Dear Commissioner:

Declarant provides the following Declaration in response to the "Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated," issued in June of 2009.

I, Ronald Fedus, declare and state as follows:

Background

1. I am a citizen of the United States residing in Queens, New York.
2. I graduated from the University of Connecticut in 1974 with a degree in psychology. I then attended the University of Guelph in Guelph, Ontario and graduated in 1978 with an undergraduate degree in biology. I next attended law school at the New England School of Law in Boston where I received a J.D. in 1983. Two years later, I received a master's level graduate degree from Northeastern University in biochemistry and molecular biology.
3. I am admitted to practice law in the states of Massachusetts and New York. I also am admitted to practice before the United States Patent & Trademark Office (USPTO). My USPTO registration number is 32,567.
4. The USPTO issued an "Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated" (Order) in a number of Enzo patent applications.

5. The Order requests an explanation for an alleged delay in filing Petitions under C.F.R. § 1.137(b) (137(b) Petition) and a showing that any delay in filing such Petitions was unintentional.

Overview of This Declaration

6. I will provide information about my duties as counsel for Enzo from the period beginning in February 1990 when I began working for Enzo up to the present.

7. I will also discuss how the prosecution of U.S. patent applications was handled by me and my general procedure for working on U.S. patent applications and responding to USPTO Actions.

8. I will address questions raised by the Petitions Attorney in the Order to Show Cause.

9. My Declaration will demonstrate that I actively prosecuted all patent matters that I was handling and that the failure to file a timely Reply and any and all delays from the time an application became abandoned to the filing of a 137(b) Petition were unintentional.

Duties from 1990 to PRESENT

10. I have been corporate and patent counsel for Enzo since February 1990.

11. My duties as corporate and patent counsel for Enzo have included prosecution of U.S. patent application families and foreign patent applications based on the U.S. patent application families, patent litigation, copyright and trademark matters, general and non-patent litigation, supply and distribution negotiations and agreements, real estate matters including office leases for blood-drawing stations, contracts, and other corporate business matters.

12. During the relevant time frames for the OSC, my patent docket included a patent prosecution docket numbering about 50 U.S. patent application families and the foreign counterparts of these U.S. patent application families. A patent application family will typically contain divisional applications in addition to continuation applications and continuation-in-part applications.

13. The numerous litigation matters in which I was involved were complicated and protracted.

14. Between early 1991 and 1993, as best as I recall, Enzo employed two patent attorneys (Elaine Brenner being the other one), and two paralegals, one of who performed primarily patent docketing. Between 1993 and 2003, I was the sole patent attorney at Enzo, except for a brief period around 2000 when there was one other patent attorney. A paralegal assisted me in patent matters beginning in 1994 until around 2004. From 2003 to at least 2006, Enzo employed two patent attorneys, including me.

Overview of Cases and Patent Matters from 1990 to 2006

15. From 1990 to the present, I have worked on a large number of complicated litigations for Enzo. See ¶ 11.

16. Some exemplary litigations are shown in tabular form hereinbelow. See Table 1.

TABLE 1: Exemplary Litigations

Litigation between Enzo and:	1991	1992	1993	1994	1995	1996	1997	1998	1999	2000	2001	2002	2003	2004	2005	2006
J&J and Ortho				■												
Institute Pasteur	■	■	■													
Calgene			■	■	■	■	■	■	■	■	■	■	■	■	■	■
Gen-Probe								■	■	■	■	■	■	■	■	■
Digene												■	■	■	■	■
Amersham												■	■	■	■	■
Affymetrix													■	■	■	■
Roche Diagnostics														■	■	■
Applera														■	■	■

17. Between 1991 and 2006, I have participated in at least one, and as many as six or more, separate litigations for Enzo during any one year. On several occasions, I have also been deposed in these matters.

18. During this same time period, I was involved in handling a number of European and Japanese oppositions of Enzo patent applications for Enzo.

19. Table 2 lists oppositions in tabular form during this time period. See Table 2.

TABLE 2: Exemplary Significant Oppositions

EP/JP Opp'n	1994	1995	1996	1997	1998	1999	2000	2001	2002	2003	2004	2005
EP0 140 308												
EP0 117 440												
EP0 285 057												
JP 2 651 442												
EP0 128 322												
EP0 286 898												
JP 2 825 090												
EP0 212 670												
EP0 231 495												
EP0 330 221												

20. As shown in Table 2, between 1994 and 2005, I was involved in at least one opposition proceeding, and as many as four or more proceedings, during any one year.

21. Between 1991 and 2006, I have handled a number of supply, distribution and licensing negotiations for Enzo. Table 3 lists some of these licensing and distribution agreements that I have handled or in which I have been involved. See Table 3.

TABLE 3: Exemplary Licensing Agreements

Company	Agreement	Exec Date
Sigma Chemical	Distributorship Agr.	September 10, 1992
Corange	Distributorship Agr.	April 25, 1994
Amersham Int'l plc	Confidentiality & Non-Use Agr.	May 20, 1994
Amersham Int'l plc	Distributorship Agr.	February 1995
Sigma Chemical	Distributorship Agr.	January 5, 1996
Li-Cor, Inc.	Confidentiality & Non-Use Agr.	February 26, 1997
Boehringer Mannheim GmbH	Mutual Confidentiality Agr.	May 9, 1997
Amersham Int'l plc	Confidentiality & Non-Use Agr.	June 12, 1997
Boehringer Mannheim GmbH	Agr. (Dideoxynucleotides) & Due Diligence	July 11, 1997
University of California (UCSF)	Clinical Study Agr.	October 7, 1997
Li-Cor, Inc.	Distributorship Agr.	October 20, 1997
Japan Tobacco	License Agr.	January 14, 1998
Affymetrix	Distributorship	April 24, 1998
NEN Life Science Products, Inc.	Distributor & Settlement Agr.	January 1, 1999
UCSF	Amendment No. 1	February 2, 1999
Gene Logic, Inc.	Limited Use Agr.	February 25, 1999
Affymetrix	Confidentiality Agr.	August 15, 2000
Gene Logic, Inc.	Confidentiality & Non-Use Agr.	March 20, 2001
Nycomed Amersham plc	Amendatory Agr.	July 16, 2001
Gene Logic, Inc.	Letter Agr.	September 7, 2001
Wyeth Pharmaceuticals, Inc.	Conf'l Disclosure & Non-Use Agr.	November 4, 2002
BASF Plant Science GmbH	Nondisclosure Agr.	December 9, 2002
Affymetrix	Amend't to Distributorship Agr.	August 28, 2003
Affymetrix	Amend't to Distributorship Agr.	September 23, 2003
SmithKline Beecham Corp.	Comm'l Field of Use Program	June 4, 2004
UCSF	Clinical Study Agr.	January 18, 2005
Lumora, Ltd.	Confidentiality & Non-Use Agr.	March 2, 2005
Gen-Probe	Purchase & Tigris Loan Agr.	Sept 29, 2005
Sigma Chemical/Yale	Settlement Agr. & Release	September 6, 2006

Docketing from 1990 to Present

22. The Order requests an explanation of the docketing system used by Enzo and how reply periods were managed upon receipt of an Office Action. *See* Order, 9. Also, the Order requests an explanation of how the one-year date from abandonment was docketed. *Id.*

23. A patent docket was maintained between early 1990 and the present for responding to patent matters.

24. In 1990, docketing was handled at Enzo by Ms. Louise Finnerty, and later by Ms. Christine Richards with direction from Ms. Elaine Brenner, who was a patent attorney.

25. In early 1990, Ms. Finnerty and/or Ms. Brenner would orally inform me of when docketed matters were due. I believe Ms. Finnerty utilized a docket sheet to track matters.

26. Ms. Finnerty left Enzo in 1990, and Ms. Richards left about one or two years later.

27. Ms. Brenner then maintained Enzo's docketing sheet alone or with clerical help. In 1992, Ms. Brenner left the employ of Enzo.

28. By 1993, I was Enzo's sole attorney.

29. In the early to mid-1990s, when my secretary opened a USPTO Action, she would stamp the receipt date on the Action. After the Office Action was stamped, she would place it on a table for later docketing. The docketing was done mostly by the secretary, though I recall instances where, in the absence of my secretary, or during periods when my secretary was falling behind with her work, I wrote or stamped the date of receipt of an Office action and entered the due date for Reply on my desk calendar.

30. From early 1990 to some time in 1994, as best as I recall, I kept track of deadlines by making a notation on my desk calendar and keeping the relevant application on my desk until after the Reply was filed. I kept a loose note on top of each file to remind myself that a reply was due.

31. During 1993, I was handling most of the prosecution related work for Enzo. I can no longer recall the names of the various secretaries I had during the period from 1994 to 1996 and Enzo's personnel records no longer include information going back to those years. In any event,

as best as I recall, handling of Office actions would have been similar to the one described in paragraph 29 above.

32. Beginning some time in 1997, Ms. Lisa Curtin, a paralegal at Enzo, began to docket deadlines for Enzo's files. She utilized a Microsoft word document with the built-in table function to create a table listing various due dates for applications. The table did not automatically calculate due dates for applications, nor did it reset deadlines which had passed or were in the extension period.

33. Enzo moved its corporate offices and research facilities several times. Enzo's corporate offices have been moved three times during my employment, most recently in June 1996. Enzo's research and clinical facilities have also been moved three times. Sometime around June of 1997 after Enzo moved its corporate offices to its present location in New York City, Ms. Curtin created a Microsoft Word table document in order to serve as an electronic calendar for keeping track of patent prosecution matters and which table could be used as a docketing tool.

34. Ms. Curtin used a Microsoft Word table as a docketing tool from which I extracted due dates to place on my desk calendar.

35. Ms. Curtin calculated the due dates based on mailing dates of Office Actions and provided a periodic (usually monthly) list that included deadlines that she entered on the list. The deadlines she entered were monthly anniversary dates for Replies until the maximum statutory period for reply. I did not find her monthly reminder lists particularly helpful because the due dates, once calculated, were generally not removed even though a Reply may already have been filed. These due dates were dropped only after expiration of the maximum statutory period for reply.

36. In situations where an application became inadvertently abandoned, I believe that revival deadlines were docketed once we became aware of abandonment, which was mostly at the time following receipt of a Notice of Abandonment.

37. Docket entries such as due dates, once calculated, were not removed after a Reply was filed but were removed or updated, if at all, only after receipt of an Office Action. As a result, the docket did not always reflect the actual status of an application.

38. It was necessary to check the application file when the patent docket did not indicate a reply was filed and/or was due.

39. Because patent docketing was manually done, there were times when due dates were missed because I was not apprised that a deadline was imminent.

40. It was my general practice to monitor pending applications, but nonetheless, a small percentage of my active prosecution matters inadvertently became abandoned.

41. Once I was alerted to receipt of an Office Action, generally by having the relevant file and Office Action placed on my desk, I placed a loose note (such as a post-it note) on the file to alert me to the deadline for filing a Reply. We were very cramped for space at the time, and did not have a separate filing area for the application files; many files were stored in cabinets or boxes. Due to lack of space, it was difficult, at times, to find a file among the boxes on top of boxes. This also meant that it was difficult, at times, to locate files to ascertain whether a Reply was still due, or if it had already been filed. Keeping the file on my desk was my way of ensuring that the relevant file would not be misplaced before I had an opportunity to prepare a Reply.

42. I could not usually tell from the docket report or any other part of our system whether a given application was pending or abandoned. We usually became aware of abandonment of an application either by way of a telephone call from the Examiner asking if we had filed a reply, or upon our receipt of a Notice of Abandonment mailed from the USPTO.

43. When a Notice of Abandonment was received, Ms. Curtin would docket for revival of the application at monthly intervals up until the one-year anniversary date from the date of abandonment. The entries included a caution that the last date for revival was the one-year anniversary date. Due to difficulties I encountered periodically in preparing a timely Reply or on occasion, preparing a Reply shortly after I learned of abandonment of an application, I found these monthly reminders helpful to ensure prompt filing of the 137(b) Petition and the Reply.

44. The abandonment of an application was not always brought to my attention in a timely fashion. This, coupled with the fact that, at times, it took several weeks and sometimes months to complete a Reply to the Office Action, caused delays in completing the Reply, which was a necessary component of the 137(b) Petition filing. I recall a few instances where I was alerted to the fact that we were approaching the one-year anniversary from the date of abandonment and I had still not succeeded in completing a Reply in spite of my diligent efforts. In those instances, I filed a continuation application as the Reply because of the realization that I would not be able to complete a Reply in a prompt manner.

45. The one-year revival dates were used as a cautionary notice to ensure that a 137(b) Petition was filed no later than the one-year anniversary. However, the one-year date was not used for the purpose of delaying the filing of the 137(b) Petition until the one-year anniversary, as evidenced by the monthly reminders entered on the docket sheets. It was my general practice to work on the reply and the 137(b) Petition on a continuing basis from the time I became aware of the abandonment until the filing of the 137(b) Petition, in addition to all the other work which I was handling at Enzo.

46. Looking back on events that took place at that time, it is now apparent that the docket system in place was not sufficiently sophisticated to ensure that deadlines were not missed. However, given the shortage of staffing and the "overworked" conditions under which we operated due to financial difficulties, we were barely able to meet deadlines, let alone try to find ways to improve our existing docketing system.

47. When attorney Natalie Bogdanos joined Enzo some time in April 2003, she and a secretary, Monique Sellers, took over prosecution related docketing functions from Ms. Curtin. I believe that the two of them followed a similar docketing system to the one used by Ms. Curtin.

48. Some time in 2005, as best as I recall, Ms. Liu assumed docketing responsibilities. Ms. Liu created her own Microsoft Outlook calendar docketing system where each month contained the month's cases due, the deadline date and the assigned attorney.

49. Later, in 2007, Ms. Liu began to provide a Master Docket on one page and formatted in Microsoft Excel. The Master Docket lists the cases, initial deadline, final deadline and assigned attorney.

50. In 2007, I asked Ms. Liu to mark completed entries by placing an electronically generated check-mark next to the completed entry. Before implementing the electronic check-mark, I was verbally informing Ms. Liu of completed PTO filings. Now I inform her by email.

Attempts to Locate Chronologies of Prosecution Matters

51. During prosecution of Enzo matters before the USPTO, it was my regular practice to maintain a chronology of activity related to the application.

52. Many of the records pertaining to the applications in issue have been lost or disposed of because of the passage of time (as long as 17 years), the moving of offices, and the lack of storage space and a central server. In addition, at least three catastrophic computer malfunctions destroyed Enzo's records pertaining to patent prosecution matters.

53. Around March of 2000, a computer containing documents related to Enzo's patent prosecutions suffered a permanent hardware failure, resulting in the loss of all records. Attempts were made to recover these records -- first by Enzo's IT department and then by a commercial computer document recovery service. *See* Exhibit of Invoice from "Drive Savers." Drive Savers was unable to recover my records because the data on my hard drive was corrupted and not useable.

54. To my knowledge, a computer belonging to Ms. Lisa Curtin malfunctioned in 2003. This resulted in the loss of the patent docket, although some of the docket records relevant to the OSC were found on a computer when we investigated matters after receiving the OSC. The Exhibits attached to this Petition which relate to docket entries were printed from that computer.

55. In 2008, as a result of Enzo's receipt of the initial Order to Show Cause why a number of granted Petitions to Revive should not be vacated, I attempted to locate hard copies of my chronologies and other documents related to the prosecution of these applications. These records described my activities in prosecuting Enzo applications, and they further demonstrated my practice of actively prosecuting patent applications.

56. I have searched Enzo's current corporate offices at 527 Madison Ave., New York, New York for my chronologies, but was unable to locate any documents related to the prosecution matters in issue. I believe that the several changes in locations made by Enzo's corporate offices and research facilities since the early 1990s have contributed significantly to my inability to locate documents.

57. On July 10, 2008, Ms. Curtin and I traveled to storage facilities in Farmingdale, New York, to search for my chronologies. We visited the "tower" storage facilities (an on-site building located in the parking lot at 60 Executive Blvd.). We also searched Westy's storage facilities (across from Enzo's offices), and brought several boxes of materials to Mr. Gene Rzucidlo of Hunton & Williams, LLP at 200 Park Avenue, 53rd Floor, New York, NY 10166. These boxes did not contain, however, my chronologies of the patent prosecutions in issue, which could not be found.

58. On August 27, 2008, I traveled again to Farmingdale to visit the tower and Westy's in a further attempt to locate any materials, documents, and records related to Enzo's patent docket. I also interviewed several individuals in Accounting, Personnel, and Finance at Enzo, to ascertain the possible locations of any of these records.

59. On September 2, 2008, Ms. Curtin and I again went to Farmingdale to visit the tower and Westy's in a further attempt to search for any materials in the tower storage facilities and in an additional storage room at Westy's.

60. On September 10, 2008, I traveled to Farmingdale with Ms. Curtin to make another effort to search for documents. We again searched the tower storage facilities.

61. To date, I have been unable to find any of these records.

62. As to matters internal to Enzo, *e.g.* matters involving only Enzo inventors, it was my practice to communicate in person, by phone, or by internal memo. The memos, chronologies, and other documentation for these matters were not found due to computer malfunctions and the amount of time between when these applications were being prosecuted and when the Show Cause order was issued by the USPTO.

***Time-frame when Specific Applications of the Order became
Abandoned and General Prosecution Practice***

63. It has always been my general practice to thoroughly and actively prosecute U.S. patent applications.

64. In most, if not the vast majority, of Enzo patent prosecution cases, I responded in a timely manner to Office Actions.

65. Where an application became inadvertently abandoned for failure to respond to an Office Action, USPTO rules required the submission of a reply to the outstanding Office Action in addition to the 137(b) Petition.

66. In responding to Office Actions, it was necessary for me to review the file history, patents and publications, the specification and the claims. At times, a Reply required the filing of one or more Declarations. In preparing the Office Action reply or Declaration, it was often necessary for me to consult with inventors, experts, and Enzo personnel.

67. It was my general practice to respond fully to an Office Action. In some cases, where additional information was required, a complete Office Action reply that addressed all grounds of rejection could not be submitted for filing with the 137(b) Petition. Therefore, I filed a continuation in order to provide a reply with the 137(b) Petition.

68. In preparing replies, I tried to actively prosecute matters by addressing each of the issues raised by the Office Actions. The necessary preparations for responding to multiple matters required a tremendous effort, especially in view of ongoing litigations and other patent and non-patent matters. These efforts were not an attempt to forestall prosecution of any application.

69. In contrast to the implications of the Show Cause Order, there could have been no motive or incentive to seek delay. In fact, there was a strong disincentive for applications filed beginning June 8, 1995 (post-GATT). These post-GATT applications have a patent term generally fixed at twenty years from issuance. A delay in prosecution would result in a shorter term of effective patent protection and would have been contrary to Enzo's goals.

Responses to Specific Questions in the Show Cause Order

70. The Order has requested a statement that the cause of delay between the date of abandonment in the matters listed in the Show Cause Order and the date of filing a grantable 137(b) Petition was not deliberate. *See* Order, 9-10.

71. I note that §1.137(b) has been revised at least twice since 1991. These amendments changed the legal standard for filing a §137(b) Petition. Under the broadest provision, now in effect, I understand that an applicant is required to make "[a] statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional."

72. I re-state that in each application listed in the Order, the entire delay in filing the required reply from the due date for the reply until the filing of a grantable Petition pursuant to this paragraph was unintentional.

73. I also re-state that the abandonments of the applications in issue were also unintentional.

74. The Order also specifically requests that the cause of delay between the date of abandonment and the date of filing a grantable Petition under 37 C.F.R. § 1.137(b) be explained. *See* Order, 9-10. Additionally, the Order also requests that the cause of delay between the date

of notification and the date of filing a grantable Petition under 37 C.F.R. § 1.137(b) be explained. *See Order, 9-10.*

75. I note that the time periods referred to in ¶ 74 overlap. I will explain why, to my knowledge, there was a delay in filing a 137(b) Petition between the date of abandonment and the Notice of Abandonment. I will also explain why there was a delay between receipt of the Notice of Abandonment and the date of filing a 137(b) Petition.

76. I will also address how these delays were unintentional. *See Order, 9-10* (asking respondent to state "how these delays were 'unintentional.'").

77. The Order also requests a showing as to the cause of delay in discovering the abandoned status of various applications (if there was such a delay in discovery) despite the "exercise of due care or diligence on the part of [t]he applicant." *See Order 9-10.* The Order requests an explanation as to why certain revival petitions were filed near the one-year period after abandonment. *See Order, 13.*

78. Finally, the Order requests an explanation of how co-pendency was verified when electing to file a continuing application. *See Order, 10.* I declare that as a general practice, I amended specifications to reflect proper copendency with related applications.

79. Copendency was verified by examination of the application records to determine the status of an application prior to the filing of a continuation.

80. As noted above at ¶52 *et seq.*, my detailed chronologies and Enzo patent dockets for most applications cannot be located despite the efforts described above (¶56 *et seq.*). To show my general practice, I will first discuss an application for which I have been able to locate some records. This is the Application having its serial number end in '073 and is subject to the present series of Show Cause Orders.

81. My actions in prosecuting the '073 Application are illustrative of my normal routine for the preparation of a Reply to an Office Action.

82. Appended hereto as Exhibits are copies of documents related to the prosecution of the '073 Application.

The '073 Application

83. This application is titled "Species of Interferon, a Process for Their Preparation and Species of Interferon Prepared Thereby," and was filed on April 10, 1992 as a continuation of the '517 application.

84. On October 15, 1992, six months after filing, I telephoned the clerk of Group 1800 to inquire about the status of this application. My records indicate that the clerk stated no action had yet been taken.

85. On December 17, 1992, two months later after the first inquiry and eight months after filing, I again telephoned the clerk of Group 1800 to inquire about the status of this application. My records indicate that the clerk stated no action had yet been taken.

86. On March 11, 1993, three months later (eleven months after filing), I requested a third status check of the patent application.

87. On March 12, 1993, I corresponded with the inventor Dr. Pravinkumar Sehgal, and I noted that "[i]t has been almost a year since we re-filed your application...[a]lthough we have been checking on its status with the clerk of group 1800 in the [USPTO] for the past four or five months, we thought it appropriate to make a formal inquiry as to its status...."

88. As is apparent from the above, I inquired into the status of this pending application several times. When no USPTO Action was received, I made appropriate inquiries with the USPTO. This was my general practice.

89. On March 23, 1993, an Office Action dated March 18, 1993, was received by Enzo and stamped accordingly.

90. The Office Action contained substantive rejections including: lack of patentable utility (§ 101), lack of enabling disclosure (§ 112, 1st ¶), indefiniteness (§ 112, 2nd ¶), anticipation (§ 102(a) and (f)), and obviousness (§ 103).

91. My records indicate that on March 23, 1993, I provided summaries of the Office Action to Drs. Rabbani and Engelhardt (Enzo officers and scientists), and the inventor, Dr. Sehgal. In my letter to Dr. Sehgal, I noted that a Rule 131 Declaration could be used to overcome the anticipation rejection over a reference cited by the PTO and that such a Declaration would need

to incorporate notebook pages evidencing reduction to practice of the invention prior to the date of the reference. I also requested meetings with Dr. Sehgal to discuss a possible Reply.

92. The commentary and suggestions of Drs. Sehgal, Rabbani and Engelhardt were necessary to prepare a complete reply to the Office Action.

93. In preparing replies to Office Actions, such as the reply in this instance, I often would have to communicate with the inventor(s) and if necessary, experts or Enzo personnel. Due to inventors' and/or officers' busy schedules, it would require some time to schedule meetings. Meetings also required preparation which included the gathering of documents, analysis of documents, and legal research. Finally, meetings also required subsequent action(s) which included follow-up meetings, the further retrieval of documents, and additional analysis and research.

94. The six month due date for a reply with all available extensions to the March 23 Office Action was September 23, 1993. I received a message on September 23, 1993, indicating the Examiner had telephoned. On September 24, 1993, I returned the telephone call to the Examiner, discovered the unintentional abandonment, and noted that I would attempt to have a reply within the following month.

95. A Notice of Abandonment was sent by the USPTO on October 4, 1993. Enzo received the Notice, which was then date-stamped October 6, 1993. Enzo also implemented a stamp on the Notice to indicate a three-month reply period, demonstrating my intent to reply promptly from the date of receipt of the Notice of Abandonment.

96. On October 12, 1993, I wrote to Dr. Sehgal and informed him that we would be assisted by another attorney, Mr. John J. Santalone (outside counsel), who would be "out of the country for the next week or so." In accordance with my request and for possible use in the Reply, Dr. Sehgal provided me with his laboratory notebooks and other documents for photocopying.

97. On October 18, 1993, a publication search was conducted at Enzo. The results revealed three patent documents. The citations for these three patents were sent to Dr. Sehgal.

98. I also corresponded with the New York Public Library Patent Depository and requested copies of the patent documents cited in the search results, which was the general practice at the time. To expedite the retrieval of these documents, I recall traveling to the New York Public

Library Patent Depository, a separate Annex facility on the West side of Manhattan, and making copies of these documents, which were stored on microfiche.

99. On October 21, 1993, copies of the retrieved patent documents were provided to Dr. Sehgal in a further letter. The letter stated my intent to send draft Declarations to Dr. Sehgal to support the replies to the Examiner's rejections.

100. On January 27, 1994, I sent a letter to the inventor regarding filing a Declaration and Reply. I stated that it is "[o]ur goal...to file a complete reply as early as possible next month (February)...." In my letter, I also sent to Dr. Sehgal a copy of a published case (*Fiers v. Sugano*). I sent this case because the prior art search uncovered a Revel EU patent document (Revel was a party to the case), and I thought it would be of interest to Dr. Sehgal.

101. In coordinating various parties who were necessary for filing a Reply, time was required to allow myself and others to review, analyze, and to comment on Office Actions, patents and publications, the specification and claims, and other related documentation. In addition to myself, many of the individuals were involved in the prosecution of more than one application. In addition to their normal duties, these other individuals also had to provide substantive information in multiple prosecutions.

102. Between January and June of 1994, I continued to prepare a Reply and a Rule 131 Declaration. I have been unable to locate my chronologies but based on my activities described above in ¶56 *et seq.*, I believe that I continued to actively engage with the inventors and Enzo personnel in order to prepare a proper and complete substantive Reply.

103. My activities between January and June of 1994 would have included telephone calls and other correspondence with Dr. Sehgal and Enzo personnel. My foundation for this belief is based on what I can recall, the records I have been able to locate, and the pattern of correspondence and active prosecution that those records demonstrate. For example, as noted above, I sent a letter on Jan 27, 1994, stating that it was my intent to "file a complete Reply as early as possible next month (February)." I also sent correspondence in June to Drs. Christine Brakel and James Donegan regarding the pending claims and Declaration. These records demonstrate I was actively pursuing the prosecution of this matter during the period between January and June of 1994. It is also my recollection that the preparation of the Reply and Declaration, which was necessary to overcome the Examiner's rejections, was particularly time-

consuming because of the technical nature of the invention, and the cited patents and publications.

104. On June 13, 1994, I sent a letter to Dr. Brakel, and requested a conference call to discuss the pending claims. I also corresponded with Dr. Brakel and Dr. Donegan regarding Dr. Sehgal's lab notebooks related to the patent application and Rule 131 Declaration.

105. On June 13, 1994, I also sent a letter to Dr. Sehgal, and reminded him of the urgency in filing a Reply. I stated:

Although we had intended to send you prior to your departure to Europe this week a draft declaration for review, it appears that with the impending deadline for petitioning the [USPTO] fast approaching, we should proceed to re-file the present application. In this way, we can thoroughly address all of the issues presented in the March 18, 1993 Office Action. The present situation has been further complicated by the absence from the country of Dr. Dean L. Engelhardt and John J. Santalone, Esq., both of whom are assisting in the prosecution of your application. As soon as both return, I will meet with them to go over some matters prior to contacting you further.

106. The 137(b) Petition, filed June 16, 1994, stated that the application was "unintentionally abandoned." This was an accurate statement as well as the entirety of what was required by way of a statement for a petition to revive based on regulations and MPEP guidelines in existence at the time. Although my activities after abandonment as explained above reflect an attempt to prepare a proper Reply during the entire period of abandonment, the language used in the Petition was the one required at the time, rather than the current required language of unintentional delay during the entire period of abandonment. Nevertheless, even with the PTO's questioning of the delay based on the current standards, I hereby state that the entire delay, from the time that a Reply was due until the filing of a grantable petition to revive, was unintentional.

107. I note that I have filed 137(b) Petitions in other cases, one of which is subject to the Show Cause Order prior to the mailing of a Notice of Abandonment. These cases include the following applications: 09/104,067; 09/561,591 (subject to Order to Show Cause) and 10/096,075.

108. The 137(b) Petition was granted on August 31, 1994.

109. In this application, there was an unintentional delay in filing a timely Reply and an unintentional delay between the date of abandonment and the filing of a 137(b) Petition. As the

above events demonstrate, I actively pursued prosecution of this matter but was unable to file a complete Reply without the necessary information and action by various individuals.

110. It was never my intention to delay prosecution of any application at any point in time. Any delay was not the result of "being too busy" or prioritizing other matters ahead of filing a Petition. The delays were beyond my control because time was needed by me to prepare a complete and substantive Reply. Time was also needed by inventors and Enzo personnel to analyze and review documents, scientific information, the specification and claims of the application, and even the Office Action.

111. In those instances where there was a delay in discovering the abandoned status of an application, the delay was the result of not receiving notification as to the abandoned status of an application, and not being otherwise aware of the abandoned status of an application.

112. In those instances where applications were revived one year from abandonment, attempts at preparing a proper Reply for inclusion in the 137(b) Petition were unintentionally delayed. As demonstrated above, I attempted to prepare a full Reply and not merely file a continuation application. However, when I was unable to prepare a full Reply because of delays beyond my control, I filed a continuation application in order to be able to complete the preparation of a proper and substantive Reply.

113. In contrast to the alleged "pattern" of abandonments and revivals suggested by the Show Cause Order, my actions in the '073 case and others demonstrate a pattern of diligence in preparing substantive Replies. Additionally, I managed ongoing litigations, was involved in contract negotiations and drafting, as well as other legal duties during this period of time.

114. My general practice in prosecuting a large docket of cases has been to actively prepare suitable replies that advance the prosecution of any given application. When my practice in prosecuting patent applications is viewed in its entirety, including the attendant responsibilities in properly prosecuting any one case, then a pattern of diligence emerges.

115. Although submission of the 137(b) Petition in the above Application may appear to be uncomplicated - because the proposed reply was a request for a continuation application - existing records demonstrate that the delay was not for purposes of acquiring an extension. The delay was the result of necessary preparations required to file a complete Reply to the Office Action. These necessary preparations include the preparation of at least one Declaration,

analysis of the file history and Office Action, correspondence and meetings with the inventor and other experts, the analysis of patents and publications, and the drafting of arguments. As noted above in ¶113, when I was unable to prepare a full Reply because of delays beyond my control, I filed a continuation to continue prosecution of the application and to complete the preparation of a proper and substantive Reply.

116. Documents such as those discussed above at ¶85 *et seq.* in the '073 application demonstrate that it was my practice to actively prosecute pending patent applications.

117. Although I do not have complete records of each of the applications at issue in the Orders, my actions with respect to the '073 application are representative of how I prosecuted the present application subject to the present Order.

118. As noted in my discussion of the docketing system above at ¶24 *et seq.*, Enzo utilized a manual docketing system which was not updated automatically after the filing of an Office Action Reply. Accordingly, I was not always aware that an application had gone abandoned because inspection of the docket would not indicate whether a reply had been filed. This required the manual inspection of records, which was not always achievable due to the occasional difficulty in locating files in our office, as explained above.

119. As a result, the applications at issue in the present Orders became unintentionally abandoned. Because I had no knowledge that an application was abandoned until notice to that effect was given to me, any delay during these time periods was unintentional. Likewise, I confirm that the abandonments in the present application were unintentional.

120. Furthermore, once aware of an unintentional abandonment, such as by receipt of a Notice of Abandonment, it was my practice to actively prepare a Reply on the merits that addressed all outstanding issues of the Office Action. As explained above, I actively pursued preparation of replies in the present Application.

121. The necessary review, preparation, analysis, drafting, revising, and finalizing, in addition to communications with persons relevant to the prosecution of the application such as the inventors, Enzo personnel, and/or experts, frequently required an extensive amount of time.

122. I utilized the time subsequent to being alerted to abandonment of an application to prepare a Reply and Rule 137(b) Petition. As it was my general practice, I believe I utilized the time necessary for preparation of a reply to file replies in the present application. In addition to

my own efforts to prepare a Reply, I was further prompted by periodic docket reminders to complete a Reply for filing along with the Petition to Revive.

123. Therefore, the delay from the time I became aware that the application was inadvertently abandoned to the time I filed the Rule 137(b) Petition was unintentional, as any delay was only the result of the need to prepare a proper, substantive Reply.

124. In the instance where a non-substantive Reply was filed, such as continuation filing, it was my general practice to attempt to file a substantive Reply. I only filed a non-substantive Reply when I determined that the preparation of a substantive Reply could not have been accomplished within the regulatory deadline in effect, at the time, for filing a petition under Rule 137(b). Incomplete Reply filings would not have advanced the prosecution of the application. Therefore, it was my practice to file a continuation to resume active prosecution of an application while I continued to prepare a proper, substantive Reply.

Discussion of Show Cause Order vis-à-vis the Present Application

125. The '621 application had three instances where the application was unintentionally and inadvertently abandoned. In the first instance, a notice to file missing parts was issued on 02/17/1994 setting a one month response period.

126. No docket log can be located for this time period and, hence, there is no documentary evidence to show how the Office action may have been docketed.

127. This is in the period prior to Ms. Curtin's taking responsibility for keeping a log and after the time when Ms. Brenner and various secretaries maintained a docket log. I do not recall how docketing was done between 1993 and 1997. I believe that some docket log may have been maintained by a secretary and that I entered due dates into my desk calendar.

128. I do not recall when I became aware of the first abandonment in the '621 application since no notice of abandonment was received by Enzo. I do not recall working on the response and on the petition to revive. It was his usual procedure to work diligently and continually on all of my prosecutions.

129. A petition with the needed reply to the Office action was mailed to the PTO on December 22, 1994 which is 280 days from the abandonment date of March 17, 1994. The petition filing

was well before the one year date from the date of abandonment and the petition was granted on March 6, 1995.

130. I was the only patent attorney at Enzo during this time period and my duties included litigations, oppositions, licensing and other general legal matters for Enzo. I do not have a specific recall of what occurred up to the filing of a petition. I do know, however, that in no case including the '621 application was there any intentional delay in the preparation of a reply and petition to revive.

131. After the revival, as far as I and Enzo knew, the '621 application was pending and awaiting action by the examiner. My records indicate that on June 7, 1995, a call was received from the PTO inquiring whether Enzo had responded to the pending Office action. An inspection of the '621 file indicated the no Office action had been received. A notice of abandonment was mailed by the PTO on June 12, 1996 and was received by Enzo on June 17, 1996. The petition and reply to the Office action was filed on October 1, 1996 by me. I could not have timely filed a response to the Office action since it was not received by Enzo. I took steps to remedy the situation after becoming aware of the abandonment in June 1996 and I acted diligently to revive the '621 application 111 days from the date of becoming aware of the abandonment.

132. I reaffirm that the delay in taking action was unintentional, and that in fact, the entire delay in filing the petition was unintentional.

133. A third Office action was received by Enzo some time after its April 4, 1997 mailing date and was stamped as received and docketed for a three month response date. I do not recall the circumstances but on November 7, 1997 my files have a notation on that I placed a call to the examiner. The examiner was told that a response and petition to revive would probably be filed by the end of 1997. I believe that the call to the examiner may have been in answer to the examiner's call inquiring as to the status of the application. The notice of abandonment was mailed to Enzo on November 12, 1997. However, it was not received by Enzo.

134. In response to a call by Enzo, the examiner left a voice mail on December 7, 1997 where the examiner indicated that the PTO computer shows that the notice of abandonment was mailed, this was no definitive proof of an actual mailing. The examiner ordered the '621 application file and promised to fax the notice of abandonment to Enzo. Shortly, thereafter on February 3, 1998, the petition to revive was mailed.

135. In the petition, I indicated that the petition filed "...within the three month period from the mailing of the Notice of Abandonment pursuant to the [] new December 1, 1997 rule."

136. A request for a continuing application and a preliminary amendment were mailed along with petition and fee. I believe that my actions in this instance evidence the fact that I never intended to delay the filing of any petition to revive or to utilize the petition filing as an improper extension of time.

A copy of the docket log is attached relative to the 3rd instance of abandonment, wherein the log was modified to include a header for reference purposes, i.e., "J10006 DOCKET LOG EXHIBIT p. 1-5". Additionally, specific entries that are not relevant to the present application have been redacted and annotated with the letter designation nn. The following entries are relevant to the present application, which was assigned by Enzo docket number ENZ-52:

Third Abandonment with Notice of Abandonment on November 12, 1997:

11/11/97 ENZ-52 - Revive (10/9/97 6 mo. deadline to respond to 4/9/97 OA passed) (Docket Log Exhibit p. 1);

12/15/97 ENZ-52 - RCF & JJS should discuss in light of JJS 12/8/97 letter (Docket Log Exhibit p. 2);

1/2/98 ENZ-52 - If notice of abandonment not received, do status check in PTO - last OA was 4/9/97; left voice mail with examiner on 12/30/97 advising notice of abandonment not yet received (Docket Log Exhibit p. 2);

2/3/98 ENZ-52(C) - Petition to Revive Application Serial No. 08/182,621 filed 1/13/94 - filed this date; Granted 4/15/98 (Docket Log Exhibit p. 3);

4/14/98 ENZ-52 - Filed Terminal Disclaimer via fax (when revived, review whether TD had to be filed as app. is pre-Gatt - also, if TD is proper, investigate whether TD's have to be filed for divisionals); Accepted by PTO 4/15/98 - Period disclaimed is 9 mos. (Docket Log Exhibit p. 4);

7/9/98 ENZ-52 - Last day to revive (last OA dated 4/9/97) (Docket Log Exhibit p. 4-5);

7/9/98 ENZ-52 - Revive (4/9/97 OA not responded to) or ASAP

NOTE: Really must be revived within 3 mos. of Notice of Abandonment (Docket Log Exhibit p. 5);

The docket entries reflect the filing of the 3rd Petition to Revive on February 3, 1998 and the grant of the Petition on April 15, 1998. The entry "NOTE: Really must be revived within 3 mos. of Notice of Abandonment!" made on July 9, 1998 clearly reflects a practice of docketing for filing a Petition to Revive within the three month period of prima facie promptness defined by PTO policy at the time.

The petition to revive was filed 83 days from the date of the notice of abandonment and 209 days from the abandonment of the application. This constitutes prompt filing of the Petition within PTO recognized time frames.

While there is no documentation to support my efforts in the filing of the petition, I followed my usual procedure for responding to an Office action and my efforts to timely file the petition to revive were diligent and continual. This time period is still the period during which I was Enzo's sole patent attorney and during which there were litigations and other legal responsibilities which I had to handle for Enzo.

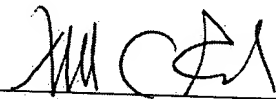
The foregoing confirms that the USPTO revivals of this application were proper.

Conclusion

137. I note that in all three instances, I submitted a 137(b) Petition within three months of receiving the Notice of Abandonment or within one year of the date of Abandonment. Furthermore, the entire delay in filing a timely reply and the entire delay in filing both petitions was related to difficulties in preparing a more timely reply, which was a necessary component of the petition process.

I further declare that all statements made herein are based on personal knowledge or upon information and belief and are believed to be true; and further that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

SIGNED



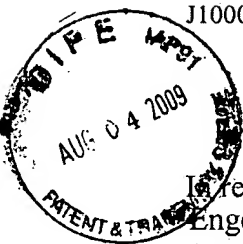
Ronald Fedus

DATED

August 3, 2009

FEDUS Declaration
for Application No:
08/182,621

CURTIN Declaration



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Engelhardt et al.
Application No. 08/182,621
Filed: January 13, 1994
Atty Docket No. ENZ-52

: OFFICE OF PETITIONS
: Ms. Nancy Johnson
: Senior Petitions Attorney

Confirmation Number: 8894

MAIL STOP PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22314-1450

RECEIVED

AUG 06 2009

OFFICE OF PETITIONS

DECLARATION BY LISA CURTIN IN SUPPORT OF PETITION FOR RECONSIDERATION OF THE ORDER TO SHOW CAUSE

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I, Lisa Curtin, provide this Declaration to answer some of the questions raised by the United States Patent and Trademark Office ("USPTO") in the Order to Show Cause issued June 2009 ("the Order") as well as in a number of Decisions rendered by the USPTO on Petitions filed in response to earlier issued Orders to Show Cause.

I am a U.S. citizen, of legal age, and a resident of Queens, New York. I am making the statements in this Declaration based on my own personal knowledge and belief. Where I have referred to or relied upon documents in making any of my statements, they are documents that I have personal knowledge of based on my recollection and past experience, and/or have reviewed in connection with preparing this Declaration.

1. I am currently employed by Enzo Biochem, Inc. ("Enzo") as a paralegal.
2. I started my employment with Enzo on a part time basis in January 1993. Ronald C. Fedus, Esq., Enzo's Patent and Corporation Counsel, engaged me at that time in order to provide paralegal litigation support services in connection with an ongoing litigation in which Enzo was involved. On January 1, 1994, I became a full-time employee of Enzo.
3. Over the years my duties at Enzo have been to provide assistance to counsel, corporate officers and marketing and sales executives in all legal matters and in all areas of the corporation's business, including Enzo's subsidiaries.
4. Prior to my employment with Enzo, I was employed by Lieberman & Nowak, LLP as a paralegal from January 1990 through December 1992.
5. I graduated from the Bronx High School of Science in 1970, and from Herbert H. Lehman College of the City University of New York in 1974 with a BA in English. I graduated in June of 1993 from New York University's Institute For Paralegal Studies, which program is fully accredited by the American Bar Association. I am not an attorney.
6. I have read the Order and I understand that the USPTO is requiring an explanation of Enzo's docketing practices and procedures in responding to Office communications, such as Office Actions and Notices of Abandonment from December 23, 1992 through November 29 2005. I am familiar with Enzo's docketing procedures during the time I had that responsibility which is from about June 1997 through about April 2003.

7. When I started working part time for Enzo in January of 1993, Enzo was located at 575 Fifth Avenue, New York, New York 10017. At that time, most of the work relating to patent prosecution was done by Ronald C. Fedus, Esq., Enzo's sole in-house attorney.

8. In June of 1996 Enzo moved its Manhattan corporate offices from 575 Fifth Avenue, New York, New York, 10017 to 527 Madison Avenue, New York, New York 10022

9. Sometime around June of 1997, I created a Microsoft Word table document in order to serve as an electronic calendar for keeping track of patent prosecution matters and which table could be used as a docketing tool.

10. At the time I began to docket prosecution matters, the legal department's secretary would place documents that needed to be docketed, such as Official Communications, including Office Actions, and the like, into a wire basket which was located in a central location easily accessible to employees. At least as often as twice a month, and often as frequently as weekly, I would review each document in the basket in order to ascertain various dates on which matters needed to be attended to. I would hand-write those dates and the actions associated with and/or required on those dates onto a legal pad in chronological order, by individual matter. I would then give the pad to the legal department's secretary who would then type my handwritten entries into the Microsoft Word table document (hereinafter the "Table Docket"), which consisted of monthly page(s) by year, i.e., June 1997, July 1997, August 1997, etc. Each of these monthly page(s) constituted a docket in and of itself ("Docket Reports"). Office Actions were docketed for reply at monthly intervals for every month going forward from the date the Office Action issued, up to six months following the Office Action issue date. As an example, if I had before me for docketing a Non-Final Office Action ("the NF OA") dated September 1, 1993 in connection

with patent application ABC ("ABC"), I would docket: 1) the date of issuance of the NF OA as September 1, 1993; and 2) I would docket October 1, 1993 as one (1) month after the NF OA issued in connection with ABC; 3) November 1, 1993 as two (2) months after the NF OA issued in connection with ABC; 4) December 1, 1993 as three (3) months after the NF OA issued in connection with ABC; 5) January 1, 1994 as four (4) months after the NF OA issued in connection with ABC; 6) February 1, 1994 as five (5) months after the NF OA issued in connection with ABC; and 7) March 1, 1994 as six (6) months after the NF OA issued in connection with ABC. After the legal department secretary typed my docket entries into the Table Docket, she would hand me a printout of the Table Docket, and I would check to see that she properly entered my handwritten notes into the Table Docket. Starting in February 2000, I began to input the dates directly into the Table Docket. The Table Docket did not automatically calculate due dates for prosecution matters, nor did the Table Docket automatically remove docket entries nor did it reset and/or recalculate deadlines. Docket entries such as due dates for responses and/or actions to be taken, were mentally calculated by me, and were manually entered into the Table Docket. Dates were generally not removed from the Table Docket, even after a response was filed or an action was taken. Accordingly, the docket did not always reflect the actual status of an application, i.e., the presence of a docket entry in the Table Docket did not necessarily mean that a response still needed to be filed or an action still needed to be taken.

11. Prior to February 2000, after I had checked the legal department's secretary's entries into the Table Docket, and had her make any corrections necessary, I would have the secretary print out either the entire Table Docket (if there were docket entries made to numerous Docket Reports), or, only the Docket Reports that had been updated (if only a few docket entries had been made to only a few Docket Reports). The secretary would then either: a) place the entire

printout of the Table Docket into a looseleaf binder which was stored alongside the basket described in paragraph 10 above, discarding the prior Table Docket contained in the looseleaf; or b) remove from the looseleaf all Docket Reports that had been updated, and place the updated Docket Reports into the looseleaf binder. At any given point, the entire Table Docket was contained in this looseleaf binder (in addition to being electronically stored on the secretary's computer. A photocopy of each hard copy printout of each updated monthly Docket Report containing the newly entered information was also provided to Mr. Fedus as they were printed. From February 2000 through April 2003 I undertook all of the foregoing steps performed by the secretary.

12. Docket Report(s) were given to Mr. Ron Fedus on at least a monthly basis. I did this by leaving a copy of the Docket Report(s) on Mr. Fedus's chair. While typically, I did not discuss with Mr. Fedus the entries on the Docket Report, I did routinely highlight with a yellow marker especially urgent deadlines which appeared on the Docket Report(s) I provided to him.

13. Space was tight at 575 Fifth Avenue, with no separate storage areas allocated for patent files. Space was also tight at 527 Madison, even though it was a larger space than 575 Fifth, and had a separate storage area with open shelving in which files could be stored. While some prosecution files were stored in this defined space, the bulk of the separate storage area at 527 Madison contained litigation files and papers. We did not have adequate drawer space in either location for all of the prosecution files, nor did we have enough separate storage space together with drawer spacer at 527 Madison to store all the prosecution files. I recall that some patent prosecution files were stored in drawers and in legal-sized transfiles in both offices, and both the drawers and the transfiles were often in physically high locations that were difficult to access.

This is not to say that files were randomly strewn about in disorderly fashion, but it was difficult to locate files and difficult to access them due to the cramped conditions. Nevertheless, on occasion, I would pull out files that needed responses, if I could locate and access them, and I would place those files on Mr. Fedus's chair as deadlines loomed. I would also have the legal department secretary scan Office Actions into WORD documents and make copies of any art cited by Examiners. For some cases, I drafted the skeletons of responses to Office Actions, adding text from the scanned Office Actions into the draft responses in order to make it easier for Mr. Fedus to reply to the Office Actions.

14. As noted in paragraph 10 above, it was not my routine to remove or cause the legal department's secretary to remove any docket entries from the Table Docket once a docket entry was entered into the Table Docket. As also noted in paragraph 10 above, it was not apparent from the Table Docket alone, or for that matter from the Docket Reports themselves whether a reply was in the process of being prepared, or in fact had been prepared, or had been prepared and mailed to the USPTO, or had not yet been prepared. Thus, one could not usually tell from the Table Docket and/or the Docket Reports alone whether a given application was pending or abandoned. I generally became aware of abandonment of an application upon my seeing a Notice of Abandonment issued by the USPTO in the aforescribed wire basket.

15. As noted in paragraphs 10 and 13 above, as the status of an application could not be determined solely from the Table Docket and/or Docket Reports, it was often necessary to pull out and review the actual patent prosecution files themselves in order to ascertain the status of an individual application. As also noted above, it was often hard to physically get to those files due to the cramped storage conditions

16. Mr. Fedus kept a "chron" file, which consisted of a large black three-ring looseleaf binder labeled as his Chron File, in which he placed copies of everything he had worked on in chronological order. When the Chron File looseleaf binder became full, he would transfer the looseleaf binder contents into soft cover binders, and those binders would be labeled as monthly chronologies, with labels bearing his name and the time frame of the papers contained in the binder. Those binders were stored, as best as I recall, in a separate storage area at 527 Madison Avenue; I do not recall where these binders were stored at 575 Fifth. At some point, his soft-covered chrons' were shipped offsite to Enzo's Farmingdale location. After the initial Orders to Show Cause issued in July 2008, Mr. Fedus and I made several trips to Farmingdale to see if we could find his chrons. We were not successful and could not locate them.

17. When a Notice of Abandonment came to my attention, my general practice was to docket it for revival at monthly intervals from the date of abandonment up until the one year anniversary date of the date of abandonment. I would also docket the application for revival utilizing the date of issuance of the Notice Of Abandonment as a starting date. Using the example set out in paragraph 10 above, if I received a Notice of Abandonment dated April 15, 1994 for failure to respond to an Office Action mailed on September 1, 1993, I (or the legal department's secretary, as instructed by me) entered in the Table Docket a revival date reminder on a monthly basis from the date of abandonment (which abandonment date was not expressly stated in the Notice of Abandonment). In the example at hand, I would have docketed the date of the issuance of the Notice of Abandonment, i.e., April 15, 1994 with a notation that the application was abandoned for failure to respond to NF Office Action which issued Sep. 1, 1993; Application abandoned as of December 1, 1993. I would have also docketed May 15, 1994 as: Revive, one month after issuance of 4/15/94 Notice of Abandonment; Application abandoned 12/1/93 for failure to

respond to 9/1/93 NF OA. Likewise, I would have docketed June 15, 1994 as: Revive, two months after issuance of 4/15/94 Notice of Abandonment; Application abandoned 12/1/93 for failure to respond to 9/1/93 NF OA. In addition to docketing from the date of the issuance of the notice of abandonment with entries for the subsequent two or three months, I would also have made docket entries calculated from the actual date of abandonment of the application, namely, I would have docketed an entry for May 1, 1994 as 5 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!. I would have docketed further as follows: a) June 1, 1994 as 6 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; b) July 1, 1994 as 7 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; c) August 1, 1994 as 8 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; d) September 1, 1994 as 9 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; e) October 1, 1994 as 10 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; f) November 1, 1994 as 11 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; and g) December 1, 1994 as 12 months after NF OA application was abandoned on December 1, 1993

for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application, with an additional notation as ABSOLUTELY LAST DAY TO REVIVE!!!.

18. After docketing, the papers from which the docket entry dates were extracted were placed in their respective files by me, or the legal department's secretary. It was not my practice to undertake any investigation as to the circumstances surrounding the abandonment of an application.

19. Sometime after attorney Natalie Bogdanos joined Enzo in April, 2003, I stopped docketing, and I continued with my other duties at Enzo, such as contract administration and drafting documents (including production distribution and licensing agreements, collaborative scientific research agreements, material transfer agreements, product testing and production agreements, confidentiality agreements (drafting, reviewing and negotiating individual, academic and corporate agreements with third parties under an attorney's direction), employment matters, including consulting and option agreements, reviewing real property leases for clinical lab services), litigation assistance, trademark matters, research, specialized database searches, and other diverse non-routine matters.

Discussion of Show Cause Order vis-à-vis the Present Application

20. I will now comment on the '621 Application at issue in the present Show Cause Order.

21. With respect to this application, copies of corresponding Docket Reports are attached in the form of a running docket log. The log includes a header for reference purposes, i.e., "J10006 DOCKET REPORT EXHIBIT p. 1-5". Specific Docket Report entries that are not relevant to the present application have been redacted and annotated with the letter designation nn. The

following Docket Report entries, which have been bolded for emphasis, are relevant to the present application, as indicated by Enzo's internal designation of "ENZ-52":

a) "11/11/97; ENZ-52 - Revive (10/9/97 6 mo. deadline to respond to 4/9/97 OA passed)" (J10006 Docket Report Exhibit p. 1);

b) "12/15/97; ENZ-52 - RCF & JJS should discuss in light of JJS 12/8/97 letter" (J10006 Docket Report Exhibit p. 2);

c) "1/2/98; ENZ-52 - If notice of abandonment not received, do status check in PTO - last OA was 4/9/97; LC; left voice mail with examiner on 12/30/97 advising notice of abandonment not yet received" (J10006 Docket Report Exhibit p. 2);

d) "2/3/98 ENZ-52(C) - Petition to Revive Application Serial No. 08/182,621 filed 1/13/94 - filed this date; Granted 4/15/98" (J10006 Docket Report Exhibit p. 3);

e) "4/14/98 ENZ-52 - Filed Terminal Disclaimer via fax (when revived, review whether TD had to be filed as app. is pre-Gatt - also, if TD is proper, investigate whether TD's have to be filed for divisionals); Accepted by PTO 4/15/98 - Period disclaimed is 9 mos". (J10006 Docket Report Exhibit p. 4);

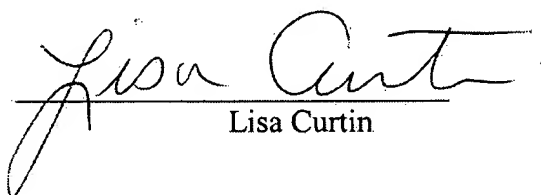
f) "7/9/98 ENZ-52 - Last day to revive (last OA dated 4/9/97)" (J10006 Docket Report Exhibit p. 4); and

g) "7/9/98 ENZ-52 - Revive (4/9/97 OA not responded to) or ASAP NOTE: Really must be revived within 3 mos. of Notice of Abandonment" (J10006 Docket Report Exhibit p. 4).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

August 4, 2009


Lisa Curtin

DOCKET REPORT

November 1997

Date	Case/Next Steps	Attorney	Status
11/1/97	ENZ-nn(EPO)	JJS	Done (may need supplement) - Decision that app. was deemed revoked was withdrawn 11/20/97
11/1/97	ENZ-nn		
11/2/97	ENZ-nn		
11/3/97	ENZ-nn(EPO)	JJS	Done
11/3/97	ENZ-nn(EPO)	JJS/RCF	
11/4/97	ENZ-nn		
11/5/97	ENZ-nn		
11/7/97	ENZ-nn(JAPAN)		
11/7/97	ENZ-nn	JJS	Amendment and Request for 1 month Ext. of time filed 11/10/97
11/7/97	ENZ-nn		
11/7/97	ENZ-nn(JAPAN)	JJS	Amendment filed 11/14/97. Are further lit refs/exper. results needed?
11/7/97	ENZ-nn		
11/10/97	ENZ-nn(CANADA)		Done by LC
11/10/97	ENZ-nn	RCF	
11/11/97	ENZ-52 - Revive (10/9/97 6 mo. deadline to respond to 4/9/97 OA passed)		
11/12/97	ENZ-nn(EPO)	JJS	Instructed associates to proceed 11/10/97 - filed 11/12/97

December 1997

Date	Case/Next Steps	Attorney	Status
12/1/97	ENZ-nn		
12/1/97	ENZ-nn(JAPAN)	LC	Forward list of corrections - see Usami's 11/12/97 letter and our 2/3/97 letter.
12/2/97	ENZ-nn		
12/2/97	ENZ-nn(CANADA)		
12/3/97	ENZ-nn(JAPAN)	JJS	
12/3/97	ENZ-nn(EPO)		
12/4/97	ENZ-nn		
12/5/97	ENZ-nn		

12/5/97	ENZ-nn		
12/7/97	ENZ-nn		
12/8/97	ENZ-nn(CANADA)		
12/14/97	ENZ-nn (EPO)	JJS	On 10/28/97 - JJS instructed associates to correct error in claims and change title. Vossius filed reply to Ruler 51(4) Communication on 12/3/97
12/15/97	ENZ-nn		Wrote to Patent Office 11/25/97 inquiring as to status.
12/15/97	ENZ-52 - RCF & JJS should discuss in light of JJS 12/8/97 letter		

January 1998

Date	Case/Next Steps	Attorney	Status
1/2/98	ENZ-52 - If notice of abandonment not received, do status check in PTO - last OA was 4/9/97	LC	left voice mail with examiner on 12/30/97 advising notice of abandonment not yet received
1/4/98	ENZ-nn		
1/5/98	ENZ-nn		
1/7/98	ENZ-nn		
1/7/98	ENZ-nn		
1/8/98	ENZ-nn(DENMARK) -	JJS	nn
1/9/98	ENZ-nn(CANADA)	RCF	Associates filed response this date
1/9/98	ENZ-nn		
1/9/98	ENZ-nn		
1/10/98	ENZ-nn	RCF	Filed 1/9/98 self-addressed postcard received back in office.
1/12/98	ENZ-nn(CANADA)		
1/14/98	ENZ-nn	RCF	Green postcard stamped 1/16/98 by PTO mailroom received back in office
1/14/98	ENZ-nn		
1/16/98	ENZ-nn(CANADA)		
1/16/98	AFFYMETRIX - Conference call 1/19/98 @ 2:30pm		
1/17/98	ENZ-nn(EPO)		Told Vossius to proceed

12/17/97

February 1998

<u>Date</u>	<u>Case/Next Steps</u>	<u>Attorney</u>	<u>Status</u>
2/3/98	ENZ-nn(EPO)	JJS	Response filed
2/3/98	ENZ-nn		postcard received back - stamped 2/3/98, no serial no.
2/3/98	ENZ-nn		postcard received back - stamped 2/3/98, no serial no.
2/3/98	ENZ-52(C) - Petition to Revive Application Serial No. 08/182,621 filed 1/13/94 - filed this date		Granted 4/15/98
2/3/98	ENZ-nn		postcard received back - stamped 2/3/98, no serial no.
2/4/98	ENZ-nn	JJS	
2/5/98	ENZ-nn	RCF	filed, postcard received back from PTO
2/6/98	ENZ-nn		
2/6/98	ENZ-nn		
2/6/98	ENZ-nn		
2/6/98	ENZ-nn		
2/7/98	ENZ-nn	RCF	Filed 2/9/98
2/7/98	ENZ-nn	JJS	
2/7/98	ENZ-nn(EPO)		
2/9/98	ENZ-nn		
2/9/98	ENZ-nn		
2/14/98	ENZ-nn		
2/15/98	ENZ-nn(CANADA)		

April 1998

<u>Date</u>	<u>Case/Next Steps</u>	<u>Attorney</u>	<u>Status</u>
4/1/98	ENZ-nn(EPO)(OPP) -	JJS	
4/2/98	ENZ-nn		
4/2/98	ENZ-nn(JAPAN) -		

4/2/98	ENZ-nn(JAPAN)		
4/2/98	ENZ-nn(CANADA) -		
4/6/98	ENZ-nn		
4/6/98	ENZ-nn		
4/6/98	ENZ-nn		
4/6/98	ENZ-nn		
4/9/98	ENZ-nn		
4/10/98	ENZ-nn		
4/10/98	ENZ-nn		
4/13/98	ENZ-nn		
4/14/98	ENZ-52 - Filed Terminal Disclaimer via fax (when revived, review whether TD had to be filed as app. is pre-Gatt - also, if TD is proper, investigate whether TD's have to be filed for divisionals).		Accepted by PTO 4/15/98 - Period disclaimed is 9 mos.
4/14/98	ENZ-nn(PCT)		nn
4/17/98	ENZ-nn		
4/18/98	ENZ-nn		

July 1998

Date	Case/Next Steps	Attorney	Status
7/1/98	ENZ-nn		
7/2/98	ENZ-nn(EPO)		
7/2/98	ENZ-nn(JAPAN)		
7/2/98	ENZ-nn(JAPAN)		
7/5/98	ENZ-nn		
7/6/98	ENZ-nn		
7/6/98	ENZ-nn		
7/6/98	ENZ-nn(EPO)		
7/6/98	ENZ-nn		
7/6/98	ENZ-nn		
7/6/98	ENZ-nn(JAPAN)		
7/7/98	ENZ-nn		
7/7/98	ENZ-nn		
7/7/98	ENZ-nn(JAPAN) -		
7/7/98	ENZ-nn(JAPAN) -		
7/9/98	ENZ-52 - Last day to revive (last OA dated 4/9/97)		
7/9/98	ENZ-52 - Revive (4/9/97 OA not responded to) or ASAP NOTE: Really must be revived within 3 mos. of Notice of Abandonment!		

7/9/98	ENZ-nn		
7/13/98	ENZ-nn(EPO)(OPP)		

Relevant Documents from **'073 Application**



Enzo Biochem, Inc.
575 Fifth Avenue
New York, NY 10017
212.856.0876
Fax: 212.856.0878

VIA FACSIMILE & FEDERAL EXPRESS
703-415-1618

March 11, 1993

Cantwell & Paxton, Inc.
Suite 1003
2001 Jefferson Davis Highway
Arlington, VA 22202

RECEIVED

AUG 06 2009

OFFICE OF PETITIONS

Attention: Mmes. Pat Paxton and Beverly Floyd

RE: U.S. Patent Application Serial No. 07/869,073
Filed: April 10, 1992
Inventor: Pravinkumar B. Sehgal
Title: Species of Interferon, A Process for Their
Preparation and Species of Interferon Prepared Thereby
Our Reference: Enz-2 (C3)

Dear Pat and Beverly:

Could you let me know, preferably by facsimile confirmation, the status of the above-identified U.S. application which was re-filed last April? We have received no correspondence except for the Filing Receipt issued in June 1992. For your use in making this inquiry, we have enclosed an executed Power to Inspect and Make Copies.

In addition, could you please file the following documents in connection with this application:

1. Change of Correspondence Request;
2. Request to Correct Filing Receipt; and
3. Revocation of Previous Powers of Attorney and Appointment of New Power of Attorney.

Mmes. Pat Paxton and Beverly Floyd
Cantwell & Paxton
March 11, 1993
Page 2

A return postcard is also enclosed in connection with the above documents. If possible, please have the clerk of Group 1800 (or other authorized Patent Office personnel) stamp the postcards. You may return the stamped postcards to us when you send me a paid receipt for this service, for which my personal check no. 1356 for \$25.00 is enclosed. Please let me know if this amount is sufficient.

We look forward to receipt of the status information and the stamped return postcards.

Cordially,



Ronald C. Fedus
Patent Counsel

Enclosures

MEMORANDUM

To: File

From: Ronald C. Fedus

Date: March 16, 1993

Re: Enz-2 (C3) [Interferon et al.]
Enz-26 (C2) [Novel One Step Method et al.]
Enz-7 (C2)(P)(C2) [Soluble Assay et al.]

Mrs. Pat Paxton of Cantwell & Paxton, our Washington associates telephoned me today to inform me that the interferon application [Enz-2 (C3)] was presently in the hands of Examiner Shelly Guest. The papers effecting changes in power and correspondence address had been filed by Pat.

With respect to the two other cases, Enz-26 (C2) and Enz-7 (C2)(P)(C2), Pat indicated that these applications were in the hands of the petitions examiner(s) who should act upon them in due course.

RF



Enzo Biochem, Inc.

575 Fifth Avenue

New York, NY 10017

212.856.0876

Fax: 212.856.0878

March 17, 1993

Dr. Pravinkumar B. Sehgal
Department of Microbiology
New York Medical College
Basic Sciences Building
Valhalla, New York 10595

Re: U.S. Patent Application Serial No. 07/869,073
Filed April 10, 1992 as a continuation of
Serial No. 07/191,517, filed May 6, 1988
Inventor: Pravinkumar B. Sehgal
For: SPECIES OF INTERFERON, A PROCESS FOR THEIR
PREPARATION AND SPECIES OF INTERFERON PREPARED THEREBY
Our Reference No.: Enz-2 (C3)

Dear Dr. Sehgal:

Further to our letter of last week, we have just been informed by our Washington associates that the new continuation application, above-identified, is presently in the hands of the patent examiner who handled the previous application.

We expect to receive a communication from the examiner in the next few weeks and will immediately apprise you when it is received.

Cordially,

A handwritten signature in dark ink, appearing to read "R. Fedus", written over a horizontal line.

Ronald C. Fedus
Corporation & Patent Counsel


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/869,073 04/10/92 SEHGAL

P ENZ-2

EXAMINER

QUEST, S

 ELAINE P. BRENNER
ENZO BIOCHEM, INC.
60 EXECUTIVE BOULEVARD
FARMINGDALE, NY 11735

18M1

ART UNIT

PAPER NUMBER

1812

22

DATE MAILED:

03/18/93

 This is a complete application for examination in charge of an application
CLASSIFIED FOR PATENTS AND TRADE MARKS

 RECEIVED
March 23 1993
RONALD C. FEDUS

☒ This application has been examined ☒ Responsive to communication filed on 4/10/92 ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-848. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

 1. ☒ Claims 12, 18, 23-26 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

 2. ☒ Claims 1-11, 13-17, 19-22, 27-40 have been cancelled.

CONFIDENTIAL & PRIVILEGED

MEMORANDUM

To: Drs. Elazar Rabbani & Dean Engelhardt
From: Ronald C. Fedus
Date: March 23, 1993
Re: Enz-2 (C3) [Interferon et al.]

After almost one year after receiving the Filing Receipt for this application, we received the attached Office Action that was issued on March 18, 1993.

In general, the Office Action contained a number of issues which were raised in the previous application. These include:

1. lack of patentable utility (§101) page 2
2. lack of enabling disclosure
(§112, 1st ¶) pages 2-3
3. indefiniteness (§112, 2nd ¶) pages 3-4
4. anticipation (§102(a) & (f)) pages 5-6
5. obviousness (§103) pages 7-8

At the outset, I would suggest that we confer on the claims which are pending in this application for the purpose of determining their suitability in terms of language and scope.

As far as the issues raised in the Office Action, I think that the indefiniteness issue (§112, 2nd ¶) can be easily handled by minor amendments to the claims. The anticipation rejection by Weissenbach et al. can also be easily handled by a so-called Rule 131 Declaration to swear behind the reference. I have some laboratory notebook pages from Dr. Pravinkumar Sehgal and will probably need some input from the inventor in order to draft and submit a proper declaration. With respect to the anticipation rejection under §102(f), this is an issue which can likewise be handled by a declaration in the name of Dr. Sehgal as the sole inventor.

Please let me know as soon as you have had an opportunity to review the Office Action. I would like to schedule an appointment with Dr. Sehgal in the coming weeks so that we can prepare a substantial response to overcome all of the remaining issues.

RWF

PHONE
MEMO

TO	Ron	DATE	9/23	TIME	AM
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	071869023	EXT	308-3154		
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				WILL CALL AGAIN	<input type="checkbox"/>
				WAS IN	<input type="checkbox"/>
				URGENT	<input type="checkbox"/>

MEMORANDUM

To: File

From: Ronald C. Fedus

Date: September 24, 1993

Re: Enz-2 (C3) [Interferon et al.]

On this date I telephoned Examiner Shelly Cermak [formerly Shelly Guest] of Group 1812 [Tel. 703-308-3154] who had telephoned the day before.

Examiner Cermak was inquiring as to whether we had filed a response to the March 18, 1993 Office Action. I informed her that we were preparing to file a response but that the application became unintentionally abandoned. I also indicated to Examiner Cermak that we were taking immediate steps to revive the application, and would be filing a Petition to Revive as well as an appropriate response sometime next month.

RF



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
87/099,872	11/10/92	ENZO THERAPEUTICS, INC.	ENZ-21001

18M1/1004
RONALD C. FEDUS, CORP. PATENT COUNSEL
ENZO THERAPEUTICS, INC.
C/O ENZO BIOCHEM, INC.
575 FIFTH AVENUE (18TH FLOOR)
NEW YORK, NEW YORK 10017

EXAMINER	
QUEST	
ART UNIT	PAPER NUMBER
1812	26

DATE MAILED:

10/04/93

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 3/18/93.
 - ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
 - ☐ Applicant's failure to timely file the response received _____ within the period set in the Office letter.
 - ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of _____ of the Notice of Allowance.
 - ☐ The issue fee was received on _____.
 - ☐ The issue fee has not been received in Allowed Files Branch as of _____.
- In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17 (i), and a verified showing as to the causes of the delay.
- If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Deigar Inc. v. Schuyler*, 172 U.S.P.Q. 513.
- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by _____ as required in the last Office action.
 - ☐ The corrected and/or substitute drawings were received on _____.
 - ☐ The reason(s) below.

RECEIVED

OCT - 6 1993

10/6/93

RJ

Robert J. Hill, Jr.
ROBERT J. HILL, JR.
SUPERVISORY PATENT EXAMINER
GROUP 1800


UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

SERIAL NUMBER 07/869,073

DATE 04/10/92

SERIAL 07/869,073

P. 07/869,073

 ELAINE P. BRENNER
 ENZO BIOCHEM, INC.
 60 EXECUTIVE BOULEVARD
 FARMINGDALE, NY 11735

 3/23/93
 RCP

1811

QUEST, S

RECEIVED

1812

22

RONALD C. FEDUS

03/15/93

☒ This application has been examined ☒ Responsive to communication filed on 4/10/92 ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 5 month(s), 0 days from the date of this letter.
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 12, 18, 23-26 are pending in the application.
 Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-11, 13-17, 19-22, 27-40 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 12, 18, 23-26 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

 PD NO. EN2-2
 FILED FOR 6/18/93 BY
 ENZO BIOCHEM, INC.
 60 EXECUTIVE BOULEVARD, FARMINGDALE, NY 11735

EXAMINER'S ACTION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Pravinkumar B. Sehgal)
Serial No.: 07/869,073) Group Art Unit: 1812
Filed: April 10, 1992) Exam'r: Shelly Guest Cernak
Title: SPECIES OF INTERFERON, A PROCESS FOR)
THEIR PREPARATION AND SPECIES OF)
INTERFERON PREPARED THEREBY)

June 16, 1994
575 Fifth Avenue (18th Floor)
New York, New York 10017

FILED BY EXPRESS MAIL

Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Box DAC

Attention: Office of Deputy Assistant Commissioner
for Patents
2121 Crystal Drive
Crystal Park 2 - Suite 913
Arlington, Virginia 22202

PETITION TO REVIVE
AN UNINTENTIONALLY ABANDONED
APPLICATION UNDER 37 C.F.R. §1.137(b)


Dear Sirs:

Applicant submit this Petition to the Commissioner under the provisions of 37 C.F.R. §1.137(b) to revive the above-identified application which was unintentionally abandoned.

The above-identified application became unintentionally abandoned after July 18, 1993, which was the date that a response to a March 18, 1993 Office Action was due. A copy of the Notice of Abandonment issued on October 4, 1993 is attached to this Petition as Exhibit A.

It is hereby requested that this application be revived because it was unintentionally abandoned and there was no intent to abandon the application. Submitted concurrently herewith and attached as Exhibit B is a proposed response in the form of a Request for Continuation Application Under 37 C.F.R. §1.60.

Enz-2(C3)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	EF414878015
Deposit Date	JUNE 16, 1994
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231	
 Ronald C. Fedus	JUNE 16, 1994 Date

Pravinkumar B. Sehgal

Serial No. 07/869,073

Filed: April 10, 1992

Page 2 (Petition to Revive an Unintentionally Abandoned Application
Under 37 C.F.R. §1.137(b) - June 16, 1994)

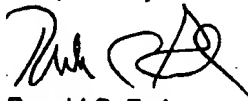
The fee for filing a Petition to Revive an Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b) is \$585.00 for a small entity. Small entity status was previously established by a duly executed Verified Statement (Declaration) Claiming Small Entity Status (37 CFR §§1.9(f) and 1.27(c)) - Small Business Concern, a copy of which accompanies the Continuation Request (Exhibit B). The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for the requisite fee of \$585.00 set forth in 37 C.F.R. §1.17(m). The Patent and Trademark Office is further authorized hereby to charge Deposit Account No. 05-1135 for any other fees required in connection with this Petition and to credit any overpayment thereto.

A duplicate copy of this Petition (but without attached Exhibits A and B) is also submitted herewith.

Favorable action on this Petition is earnestly solicited.

If helpful to the processing of this Petition or the accompanying Continuation Request, the undersigned may be contacted by telephone during the daytime hours at 212-856-0876.

Respectfully submitted,



Ronald C. Fedus
Registration No. 32,567
Attorney for Applicant

ENZO THERAPEUTICS, INC.
c/o Enzo Biochem, Inc.
575 Fifth Avenue (18th Floor)
New York, New York 10017
Tel. (212) 856-0876

Enz-2(C3)



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

JLB/JVN/jlb.8

Paper No. 29

Ronald C. Fedus, Corp. Patent Counsel
Enzo Therapeutics, Inc.
C/O Enzo Biochem, Inc.
575 Fifth Avenue (18th Floor)
New York, New York 10017

COPY MAILED

AUG 31 1994

**OFFICE OF PETITIONS
IN PATENTS**

In re Application of
Pravinkumar B. Sehgal
Serial No. 07/869,073
Filed: April 10, 1992
Attorney Docket No. ENZ-2(C3)

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 16, 1994, to revive an unintentionally abandoned application.

The petition is granted.

Since this application is being revived for purposes of continuity only and since continuity has been established by this decision reviving the application, the application is again abandoned in favor of the continuing application.

If the continuing application is one filed under 37 CFR 1.60 or 1.62, applicant must file a written notice in the continuing application within ONE MONTH from the mail date of this decision indicating that the present application has been revived for purposes of continuity and, accordingly, that the continuing application complies with the copendency requirements of the rules. The failure to file such a notice may result in the continuing application being inadvertently returned to applicant.


The statement that the "abandonment was unintentional" does not comply with 37 CFR 1.137(b).¹ However, the statement presented will be accepted and construed as meaning that the "delay was unintentional." If this is an incorrect interpretation in view of the new rules, petitioner is required to provide a statement to that effect.

¹ Effective September 20, 1993. See "Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents," published at 1154 Official Gazette 4 (September 14, 1993).

Serial No. 07/869,073

Page 2

The file is being forwarded to Group 1800.


Jeffrey V. Nase, Director
Office of Petitions
Office of the Assistant Commissioner
for Patents

WEINER Declaration



RECEIVED

AUG 06 2009

DECLARATION OF BARRY WEINER IN SUPPORT OF PETITION FOR
RECONSIDERATION OF ORDER TO SHOW CAUSE

OFFICE OF PETITIONS

Sir:

Declarant provides the following Declaration in response to the "Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated," issued in July of 2008.

I, Barry Weiner, declare and say that:

My Background

1. I am a citizen of the United States residing in New York City.
2. Enzo is a New York corporation with a principal place of business at 60 Executive Blvd., Farmingdale, New York 11735, and has one of its corporate offices at 527 Madison Avenue, New York, New York 10022.
3. I am a co-founder, President and Chief Financial Officer of Enzo Biochem, Inc. ("Enzo").
4. I have held various management positions in Enzo since 1979.
5. I have a thorough knowledge of Enzo's financial status since 1979.
6. The United States Patent and Trademark Office (USPTO) issued in July of 2008 an "Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated" which was expunged in June 2009 in favor of another "Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated" (Order).
7. The Order requests an explanation for the alleged delay in filing various petitions to revive and a showing that any delays in filing such petitions were unintentional.

Overview of the Declaration

8. I will first provide some background on Enzo followed by a discussion of the financial difficulties the company endured for the better part of a decade beginning in the late 1980s.
9. I will then comment on the company's response to its financial difficulties and how it functioned with limited resources during this period of financial crisis. I will

explain the circumstances as to why Enzo was unable to increase the number of legal staff employed (particularly attorneys) until around 2003, how Enzo was financially victimized by events which occurred in the early 1990s, and how these events led to a cautious mindset in the management of Enzo. In fact, during these years Enzo had to manage with minimal executive and management staff, including its in-house legal staff.

10. Finally, I will comment on Mr. Ronald Fedus who is presently the Corporation and Patent Counsel for Enzo. I will discuss Mr. Fedus' duties and his workload as primary (and at times sole) legal counsel for Enzo with respect to patent and other legal matters from February 1990 to the present. I know Mr. Fedus as a hard-working employee who actively attended to his duties.

Background of Enzo

11. Enzo was founded in 1976. Since then, Enzo has concentrated on the development of enabling technologies in the areas of gene regulation, gene modification, and nucleic acid detection. Enzo's technologies are applicable to the biomedical and pharmaceutical research markets. For example, one such technology led to the development of today's most widely utilized molecular diagnostic assay—the Human Papillomavirus test (HPV). This test is the standard of care for women undergoing gynecological examinations and is thought to be a key factor in the decline in incidence of cervical cancer. Enzo's discoveries are also used in the identification of various genetic disorders as well as in the process of drug discovery.

12. The business activities of Enzo Biochem are performed by Enzo's three wholly owned subsidiaries: Enzo Life Sciences, Enzo Therapeutics and Enzo Clinical Labs.

13. These activities include research and development, manufacturing and marketing of biomedical research products and tools through Enzo Life Sciences, the research and development of therapeutic products through Enzo Therapeutics, and the operation of a regional clinical reference laboratory through Enzo Clinical Labs.

Onset of Financial Difficulties

14. Enzo's financial difficulties began in the late 1980s and extended up to about 1996. These financial difficulties were largely the outgrowth of a disputed collaborative matter between Enzo and a large corporate partner. The partner suspended payments required by its collaboration agreement with Enzo resulting in protracted litigation from 1987 to about 1993.

15. In further detail, Enzo entered into a collaboration agreement with this large corporate partner in the early 1980s. The subsidiary of this corporate partner entered into an agreement to pay Enzo a significant sum over a four and one-half year period in support of research and development projects which could be extended into the future. After paying less than half the amount owed, the subsidiary reneged. The resulting loss of revenues - including the later costs of litigation - further harmed Enzo's financial status. The ongoing dispute with the subsidiary caused Enzo enormous harm in the marketplace, because Enzo was unable to pursue business opportunities with other partners while the matter was pending in court. In the early and mid 1990s, outside legal counsel was hired for litigation matters (but not for patent prosecution matters). Enzo paid outside legal counsel on a contingency basis or by payment with company stock.

16. Enzo's dealings with this corporate partner impacted Enzo's financial condition with respect to other matters as well. The dispute impacted separate financial obligations related to bonds, a lease and the attempted renovation of a real estate property, all of which resulted in a further deterioration in Enzo's financial state.

17. Bond obligations went into default because of the corporate partner's suspension of payments. Enzo's survival required the company to undergo a radical restructuring and downsizing. In 1992, Enzo was even involved in discussions for a "prepackaged bankruptcy," which is a financial reorganization plan made in cooperation with a company's creditors in preparation for bankruptcy.

18. Additionally, costly and time-consuming renegotiations with numerous individual bond-holders were necessary.

19. Because the early 1990s were a critical time-period in biotechnology for growth, Enzo lost a crucial foot-hold in the market. In sum, Enzo only survived this

difficult period by negotiating with debt holders and undertaking radical cost-saving steps throughout the company and its operations.

Responding to Financial Difficulties Required Stern Measures

20. In light of these financial difficulties, Enzo's very survival required stern measures affecting all operations of the company. These financial difficulties also limited Enzo's ability to provide additional resources to Mr. Fedus from the early 1990s to around 1996. Further, in view of these past difficulties, Enzo acted prudently post-1996, even as Enzo's financial state began to improve, by continuing a conservative approach to management of overhead and operations. This meant that executives and management, including Enzo's law department, undertook extensive workloads and responsibilities in order for the company to survive.

21. Enzo proceeded cautiously by utilizing existing personnel who had proven themselves to be reliable.

22. Even when financial conditions improved somewhat in 1996, Enzo continued its fiscal conservatism in its management and operations. Enzo did not significantly expand its personnel, particularly executive personnel including legal staff, out of concern that further financial difficulties might be encountered.

Functioning with Limited Resources

23. Enzo's poor financial condition in the early 1990s up to 1996 only allowed Enzo to operate on a "shoestring" budget. During one period from around 1990 to 1992, Enzo moved its corporate headquarters into a three room space in New York City which served as Enzo's temporary corporate offices. Mr. Fedus worked with two other Enzo employees from one room in this office space while the remaining executive functions of the company were run from the other two rooms.

24. Enzo has always been careful about budgeting its resources and therefore it has been Enzo's practice to not actively seek out expensive litigation. Nonetheless, during the early 1990s, Enzo was involved in a number of litigations (primarily breach of contract disputes relating to, for example, distributorship agreements). Most of these matters were instigated by the adverse party. Enzo generally paid outside legal counsel

on contingency or through the payment of company stock because of Enzo's financial condition.

25. Enzo personnel were relied upon to manage the operations of Enzo. Mr. Fedus was called upon to manage Enzo's intellectual property assets and legal concerns because of his track record of good performance. Enzo eventually began to expand the number of upper-level personnel, including legal personnel, around the mid-2000s but only after a thorough vetting process. It was not until 2003 that Enzo hired an additional patent attorney (Ms. Natalie Bogdanos) as a full-time employee. Presently, Mr. Fedus and Ms. Bogdanos are the only attorneys employed by Enzo.

26. From 1994 to around 2003, Enzo hired no additional executive personnel. Some executives and legal staff (Mr. Fedus) had to take on multiple responsibilities during this period of time. In sum, Enzo undertook a prudent financial approach to management of the business in order to survive.

27. These circumstances led to significant demands made not only on Enzo's law department, but on all of Enzo's management and operations. Thus, Enzo's desire to maintain a small network of proven employees resulted in Mr. Fedus having to undertake an extraordinary number of additional responsibilities.

28. Enzo has always placed a high value on its intellectual properties, viewing its patent estate as the company's most precious asset. Mr. Fedus was charged with the responsibility of protecting and enhancing this important corporate asset. As Mr. Fedus is a professional and experienced patent attorney, registered to practice before the USPTO, with solid law-firm patent prosecution experience behind him, I and my fellow corporate executives have always relied on him to fulfill his responsibilities, particularly in regards to Enzo's patent portfolio. While Mr. Fedus' assignments were numerous and varied, there was no reason for management to suspect that he could not effectively handle the various responsibilities entrusted to him. Mr. Fedus was given the authority to act with virtually complete autonomy as he prosecuted Enzo's patent applications. He outsourced prosecution work on an as needed basis and as Enzo's financial condition permitted. He and his support staff maintained a calendar and docket system. He independently reviewed and approved bills for services, including disbursements, from

outside counsel and experts he independently selected and engaged in connection with prosecuting and enforcing Enzo's patents and rights worldwide.

29. Based on the success of Mr. Fedus' efforts in maintaining and increasing Enzo's patent portfolio, I and my fellow executives had every reason to believe that Mr. Fedus continually performed an outstanding job in securing and protecting Enzo's worldwide patent portfolio.

30. I am also aware that Mr. Fedus has competently handled numerous other non-patent legal matters for Enzo.

31. In my opinion, Mr. Fedus attends to all legal matters in a professional and conscientious manner.

32. It is my belief that Mr. Fedus acted professionally in addressing each matter he handled, both patent related and non-patent related, in a thorough and timely manner.

33. As President of applicant Enzo, I categorically state that Enzo never intended to nor was Enzo motivated in any way to abandon its inventions or to intentionally delay filing responses in any of Enzo's pending patent applications beyond statutorily permitted deadlines.

34. Indeed, Enzo had every reason and need to actively and vigorously pursue its patent portfolio, which formed the very basis for the company's survival and growth and which underlie its products, technologies, distributorships, licensing efforts, enforcement litigations, commercial relationships, reputation, scientific collaborations with academia, and the like. In light of the financial circumstances Enzo had experienced, it would have been a total contradiction for Enzo *not* to pursue and obtain its patents as vigorously and as timely as possible.

35. Enzo only stood to gain from acquiring patents; there was absolutely no reason which would have benefitted Enzo in delaying their acquisition. Indeed, delaying the acquisition of patents could only hurt Enzo which had several extensive distributor relationships with life sciences companies. Upon issuance of patents to Enzo, more products were distributed and greater revenue was generated for the company. Thus, the issuance of patents was crucial to Enzo's survival and financial well-being.

36. Further, products protected by patents provided a revenue stream for a substantial period of time clear of competitor's infringing goods, and at the same time patent-protected products protected the public from acquiring possibly inferior goods. Securing patents also allowed Enzo to cultivate other new and valuable business relationships for distributing Enzo products to the marketplace.

Mr. Ronald Fedus

37. In 1991, Enzo's legal staff consisted of Mr. Ronald Fedus, Mr. Serle Mosoff, Ms. Elaine Brenner, and Ms. Hilary Smith (who was not a patent attorney).

38. By 1992, Enzo's legal staff was reduced to Mr. Fedus and Ms. Brenner and finally, from 1993 until about 2003, Mr. Fedus was Enzo's sole in-house patent lawyer with the exception of one other attorney who was briefly employed for about a one year period around 2001.

39. When Mr. Fedus joined Enzo in early 1990, he inherited a U.S. prosecution docket of almost 50 families of patent applications and their foreign counterparts. He was also given responsibility for dealing with non-patent matters involving the Company.

40. Mr. Fedus' workload increased as Enzo's legal staff dwindled. As I explained earlier, Enzo, like most developing companies, desired to expand and grow but a series of financial difficulties, primarily in the early 1990s, prevented this expansion and growth from occurring.

41. Mr. Fedus' duties as Corporation and Patent Counsel are broad and far-ranging. Mr. Fedus has, for example, primary responsibility for Enzo's patent and trademark matters including U.S. and foreign patent and trademark prosecution, opposition and interference proceedings, and litigation involving Enzo's intellectual property rights. In addition, Mr. Fedus handled non-intellectual property matters including real estate transactions, licensing matters and contracts.

42. The United States Patent and Trademark Office (USPTO) has issued a number of "Show Cause Orders" affecting several Enzo patents and patent applications. These Orders question whether Mr. Fedus' failure to file timely replies to certain U.S. prosecution matters may have been intentional.

43. I personally know that Mr. Fedus has successfully prosecuted numerous patent applications into patents.

44. I also personally know that he has competently and timely handled numerous other, non-patent legal matters.

45. In my opinion, Mr. Fedus attends to all legal matters in a professional and conscientious manner.

46. It is my belief that Mr. Fedus addressed all patent prosecution matters in the proper manner by giving each matter its necessary and thorough review and analysis.

47. It is my understanding that, in prosecuting U.S. patent applications, Mr. Fedus received Office Actions from the USPTO, and prepared responses and claim amendments in these applications. He did this by reviewing the file histories of the relevant cases, any cited prior art, and interviewing inventors and other technical experts. I specifically recall many instances where Mr. Fedus interviewed inventors and technical experts.

48. Each action required Mr. Fedus to perform a number of acts to ensure that the matters were well handled because patents are critical assets for Enzo. It has been Enzo's ongoing business plan to develop and market new and innovative technologies; therefore, Enzo has always placed a high value on ensuring the proper procurement and maintenance of patent protection.

49. It is my opinion that Mr. Fedus acted professionally in addressing each matter in a thorough manner which required extensive analyses and review from scientific, technical and legal standpoints, especially in view of the amount of work he was handling with limited resources.

50. It is because Mr. Fedus actively and thoroughly attended to all matters, that certain responses may have been unintentionally delayed.

51. I certainly do not believe that any delay was an intentional action by Mr. Fedus to forestall prosecution. My basis for such belief includes Mr. Fedus' record for timely prosecuting other matters, his general reputation, my personal experience with Mr. Fedus, and the fact that Enzo needed to obtain patents for inventions considered to be substantial assets of the company. In fact, Mr. Fedus was intimately involved in a number of distribution agreements with other life sciences companies for Enzo products

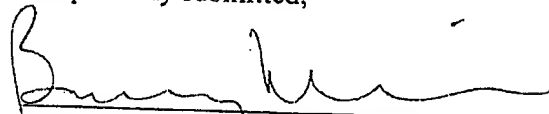
which were protected by U.S. and foreign patents. Typically in those distribution agreements, more products were distributed and higher revenues were generated for Enzo upon issuance of its patents and without the need for further negotiations.

52. Thus, it would have been altogether contrary to Enzo's interests to delay the issuance of any patent because Enzo's patent portfolio was vital to the company's financial well-being, as well as its future growth and survival.

I declare that all statements made herein are based on personal knowledge or upon information and belief and are believed to be true; and further that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

8/3/09
Date

Respectfully submitted,


Barry Weiner, President & CFO
Enzo Biochem, Inc.